



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

CUSTOMER NO. 22927

Appellants: Jay S. Walker, Daniel E. Tedesco, James A. Jorasch,
Robert R. Lech, and Sanjay K. Jindall

Application No.: 09/613,361

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Title: METHOD AND APPARTUS FOR ISSUING AND
MANAGING GIFT CERTIFICATES

Attorney Docket No. 96-140-C1

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Group Art Unit: 3624

Examiner: Colbert, Ella

APPEAL BRIEF

BOARD OF PATENT APPEALS
AND INTERFERENCESMail Stop: Appeal Brief
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Appellants hereby appeal to the Board of Patent Appeals and Interferences from the decision of the Examiner in the Final Office Action mailed October 18, 2005 (Part of Paper No. / Mail Date 09613361).

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REAL PARTY IN INTEREST

The present application is assigned to Walker Digital, LLC, Two High Ridge Park, Stamford, Connecticut 06905.

RELATED APPEALS AND INTERFERENCES

No interferences or appeals are known to Appellants, Appellants' legal representative, or assignee which will directly affect, be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims **70-79 and 81-91** are pending in the present application.

Claims **70-79 and 81-91** stand rejected under 35 U.S.C. §103(a) as being unpatentable over a combination of :

U.S. Patent No. 5,909,673 to Gregory (“Gregory” herein); and

U.S. Patent No. 5,377,271 to Foreman et al. (“Foreman” herein).

STATUS OF AMENDMENTS

No amendments were filed subsequent to the Final Office Action mailed October 18, 2005, the rejections of which are being appealed herein.

SUMMARY OF CLAIMED SUBJECT MATTER

Concise explanations of the independent claims being appealed are provided below. The summaries include sufficient information about the claimed subject matter so that an informed review of the Examiner's adverse determination of patentability can be made.

As required by 37 C.F.R. § 41.37(c)(1)(v), reference is made to the Specification and Drawings, as appropriate. Any such reference:

- (i) is by way of example of the claimed subject matter only;
- (ii) is to be considered as potentially useful in clarifying the particular subject matter of the particular independent claim being explained (and not other claims or "the invention" as a whole), unless explicitly stated otherwise; and
- (iii) is not to be considered as broadening or narrowing the scope of any recited term from its meaning to one of ordinary skill in the art, unless explicitly stated otherwise.

Of the claims being appealed, only claims **70, 73, 76, 77, 78, 79, 81, 83 and 91** are independent.

1. Independent Claim 70

In accordance with one or more embodiments of the present invention, a method for issuing a gift certificate corresponding to a financial account provides for *generating, by a computer, a certificate identifier corresponding to an account identifier that is associated with a financial account, said certificate identifier being different from said account*

identifier. See, for example, the specification, page 9, line 20 to page 10, line 6 and Fig. 1.

The method further provides for *producing a gift certificate including thereon said certificate identifier.* See, for example, specification, page 9, line 20 to page 10, line 5 and Fig. 1; and page 17, lines 10 – 13 with reference to Fig. 8.

The method further provides for *said gift certificate not including said account identifier.* See, for example, specification, page 10, lines 5-6, and page 17, lines 18 – 21 with reference to Fig. 8.

The method further provides for *distributing said gift certificate to an owner of said financial account.* See, for example, specification, page 10, lines 9 – 10 and Fig. 1; and page 21, lines 19 – 21.

2. Independent Claim 73

In accordance with one or more embodiments of the present invention, a method for issuing a gift certificate corresponding to a financial account provides for:

generating, by a computer, a certificate identifier corresponding to an account identifier that is associated with a financial account, said certificate identifier being different from said account identifier;

producing a gift certificate including thereon said certificate identifier, said gift certificate not including said account identifier.

The description above concerning method claim 70, including example support from the specification and figures, is equally applicable to these elements of claim 73, and for purposes of brevity will not be repeated.

The method further provides for *distributing said gift certificate to a recipient*. See, for example, specification, page 10, lines 11– 15 and Fig. 1; page 14, lines 15 – 18; page 14, line 23 to page 15, line 3; page 17, lines 10 –13 and Fig. 8.; and page 22, lines 1– 4.

3. Independent Claim 76

In accordance with one or more embodiments of the present invention, a system for issuing a gift certificate corresponding to a financial account provides for *computer means for generating a certificate identifier corresponding to an account identifier that is associated with a financial account, said certificate identifier being different from said account identifier*. See, for example, the specification, page 9, line 20 to page 10, line 6, and Fig. 1; page 11, line 11 to page 12, line 4 and Fig. 2.

The system further includes *means for producing a gift certificate including thereon said certificate identifier*. See, for example, specification, page 9, lines 20 – 22; and page 11, line 11 to page 12, line 4 and Fig. 2.

The system further comprises *said gift certificate not including said account identifier*. See, for example, specification, page 10, lines 5-6, and page 17, lines 18 – 21 with reference to Fig. 8.

The system also includes *means for distributing said gift certificate to an owner of said financial account*. See, for example, specification, page 10, lines 9 – 10 and Fig. 1; page 11, line 11 to page 12, line 4 and Fig. 2; and page 21, lines 19 – 21.

4. Independent Claim 77

In accordance with one or more embodiments of the present invention, a system for issuing a gift certificate drawn on a financial account includes *computer means for generating a certificate identifier corresponding to an account identifier that is associated with a financial account, said certificate identifier being different from said account identifier*. The system also comprises *means for producing a gift certificate including thereon said certificate identifier, said gift certificate not including said account identifier*. The description concerning system claim 76, including example support from the specification and figures, is equally applicable to claim 77, and for purposes of brevity will not be repeated.

The system of claim 77 further includes *means for distributing said gift certificate to a recipient*. See, for example, specification, page 10, lines 11– 15 and Fig. 1; page 11, line 11 to page 12, line 4 and Fig. 2; page 14, lines 15 – 18; page 14, line 23 to page 15, line 3; page 17, lines 10 –13 and Fig. 8.; and page 22, lines 1– 4.

5. Independent Claim 78

In accordance with one or more embodiments, the invention comprises *a computer-readable storage medium encoded with processing instructions for implementing a method for issuing a gift certificate drawn on a financial account*. See, for example, specification, page 11, line 11 to page 12, line 4.

The processing instructions define a process for directing a computer to perform operations that are identical to the process steps recited by independent method claim 70 above. Thus, the description above of the method of claim 70, including example support in the specification and figures, is equally applicable to claim 78 and will not be repeated here, for purposes of brevity.

6. Independent Claim 79

In accordance with one or more embodiments, the invention comprises *a computer-readable storage medium encoded with processing instructions for implementing a method for issuing a gift certificate drawn on a financial account*. See, for example, specification, page 11, line 11 to page 12, line 4.

The processing instructions define a process for directing a computer to perform operations that are identical to the process steps recited by independent method claim 73 above. Thus, the description above of the method of claim 73, including example support in the specification and figures, is equally applicable to claim 79 and will not be repeated here, for purposes of brevity.

7. Independent Claim 81

In accordance with one or more embodiments, a method includes *producing a gift certificate, the gift certificate including a sixteen-digit certificate identifier, in which the sixteen-digit certificate is determined by a computer, in which the sixteen-digit certificate identifier is an alias of an*

account identifier that identifies a financial account, and in which the account identifier identifies a credit card account. See, for example, page 9, line 20 to page 10, line 10, and Fig. 1; and page 17, lines 10 – 23, and Fig. 8.

The method of claim 81 further includes *distributing the gift certificate to an owner of the credit card account.* See, for example, specification, page 10, lines 9 – 10 and Fig. 1; page 21, lines 19 – 21.

8. Independent Claim 83

In accordance with one or more embodiments, a method includes *determining stored account data associated with a financial account, in which the account data includes an account identifier that identifies the financial account.* See, for example, page 12, line 21 to page 13, line 4, and Fig. 4.

The method further includes *generating, by a computer, an alias identifier that provides an indirect link to the financial account, in which the alias identifier is different from the account identifier.* See, for example, page 10, lines 3-6, and Fig. 1; and page 14, lines 7 – 10, and Fig. 5.

The method further includes *producing a gift certificate, the gift certificate including the alias identifier.* See, for example, specification, page 9, line 20 to page 10, line 6; and page 17, lines 10 – 13 with reference to Fig. 8.

The method further includes *providing the gift certificate to a recipient.* See, for example, page 10, lines 11 – 15 and Fig. 1; page 14, lines 15 – 18; page 14, line 23 to page 15, line 3; page 17, lines 10 – 13 and Fig. 8.; and page 22, lines 1 – 4.

9. Independent Claim 91

In accordance with one or more embodiments, a method includes *determining stored account data associated with a financial account, in which the account data includes an account identifier that identifies a credit card account.* See, for example, page 12, line 21 to page 13, line 4, and Fig. 4.

The method further includes *generating, by a computer, an alias account number that provides an indirect link to the credit card account, in which the alias account number is different from the account identifier, and in which the alias account number comprises at least fifteen numeric digits.* See, for example, the specification, page 9, line 20 to page 10, line 6, and Fig. 1; page 11, line 11 to page 12, line 4 and Fig. 2; page 13, lines 1– 4, and Fig. 4; page 14, lines 7– 10, and Fig. 5.

The method further provides for *producing a magnetic stripe card, the magnetic stripe card including the alias account number.* See, for example, page 9, line 20 to page 10, line 1.

The method further provides for *providing the magnetic stripe card to a recipient.* See, for example, page 10, lines 11-15.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims **70-79 and 81-91** stand rejected under 35 U.S.C. §103(a) as unpatentable over Gregory in view of Foreman.

ARGUMENTS

1. Summary of Arguments

The rejections fail for various reasons.

- The rejections under 35 U.S.C. §103(a) for obviousness fail because a *prima facie* case has not been established. The Examiner has not provided any factual findings in support of any rejection, and has not provided substantial evidence in support of any rejection. Accordingly, without more and according to law, Appellants are entitled to allowance of the claims.
- The rejections under 35 U.S.C. §103(a) for obviousness fail because the recitations constitute conclusory statements and unsupported allegations, ignore claim limitations, and are completely devoid of any motivation to combine the references. Further, the references do not, alone or in combination, teach all of the limitations of any claim being appealed. Yet further, the references do not provide any motivation for such combinations, and even if they were combined (and again, there is no teaching or suggestion to do so), such combinations do not result in the claimed invention.

Accordingly, the rejections are inappropriate and incorrect. Thus, Appellants respectfully request that the rejections be reversed.

2. Form of Appeal Brief

In the arguments herein, limitations of the claims are indicated in *italics*, claim numbers are indicated in **bold**, and the references of record are indicated by underlining.

In separate arguments of patentability of different Groups of claims, Appellants have, where possible, referred to prior arguments to avoid undue repetition.

In the arguments below, Appellants refer to the Final Office Action, which is the office action the rejections of which are being appealed herein, and which was mailed on October 18, 2005 as part of Paper No. / Mail Date 09613361.

3. Section 103(a) Rejections

All of the pending claims **70-79 and 81-91** stand rejected under 35 U.S.C. §103(a) as unpatentable over Gregory in view of Foreman. Applicants traverse these rejections.

The Examiner has not established substantial evidence of record that would support a *prima facie* case of obviousness of any claim.

Specifically, there is no substantial evidence that:

(i) would support any finding that all of the features of any claim are suggested by the cited references, alone or in any combination; or

(ii) would support any finding that a motivation existed at the time of invention to provide for all of the features of any claim.

Claims **70, 76 and 78** are argued as a separate group (Group I);

Claims **73, 77 and 79** are argued as a separate group (Group II);

Claims **71 and 74** are argued as a separate group (Group III);

Claims **72 and 75** are argued as a separate group (Group IV);

Claim **81** is argued as a separate group (Group V);

Claims **82 and 84** are argued as a separate group (Group VI);

Claim **83** is argued as a separate group (Group VII);

Claim **85** is argued as a separate group (Group VIII);

Claim **86** is argued as a separate group (Group IX);

Claim **87** is argued as a separate group (Group X);

Claim **88** is argued as a separate group (Group XI);

Claim **89** is argued as a separate group (Group XII);

Claim **90** is argued as a separate group (Group XIII); and

Claim **91** is argued as a separate group (Group XIV).

3.1. The Proper Legal Standard under 35 U.S.C. § 103(a)

The Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. *In re Fritch*, 23 U.S.P.Q.2D 1780, 972 F.2d 1260, 1265 (Fed. Cir. 1992). To reject claims in an application under Section 103, an examiner must show an unrebutted prima facie case of

obviousness. In re Rouffet, 47 U.S.P.Q.2D 1453, 149 F.3d 1350, 1355 (Fed. Cir. 1998). If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent. In re Oetiker, 24 U.S.P.Q.2D 1443, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

The factual predicates underlying an obviousness determination include the scope and content of the prior art, the differences between the prior art and the claimed invention, and the level of ordinary skill in the art. In re Rouffet. The secondary considerations are also essential components of the obviousness determination. In re Rouffet.

When a rejection is based on a combination of references, the Examiner can satisfy the *prima facie* burden only by showing some objective teaching leading to the purported combination of references. In re Fritch. Lacking a motivation to combine references, there is no *prima facie* case of obviousness. In re Rouffet, 47 U.S.P.Q.2D 1453, 149 F.3d 1350, 1355 (Fed. Cir. 1998).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 5 U.S.P.Q.2d 1596, 837 F.2d 1071 (Fed. Cir. 1988); In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992). Prior knowledge in the field of the invention must be supported by tangible teachings of reference materials, and the suggestion to combine references must not be derived by hindsight from knowledge of the invention itself. Cardiac Pacemakers v. St. Jude Medical 381 F.3d 1371, 1376 (Fed. Cir.

2004). Furthermore, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. In re Kotzab, 55 U.S.P.Q.2D 1313, 217 F.3d 1365, 1371 (Fed. Cir. 2000).

A finding of obviousness requires that the art contain something to suggest the desirability of the proposed combination. In re Grabiak, 226 U.S.P.Q. 870, 769 F.2d 729, 732 (Fed. Cir. 1985). In the absence of such a showing, there is inadequate support for the position that the proposed modification would *prima facie* have been obvious. Id. The absence of such a suggestion to combine is dispositive in an obviousness determination.

Gambro Lundia AB v. Baxter Healthcare Corp., 42 U.S.P.Q.2D 1378, 110 F.3d 1573, 1579 (Fed. Cir. 1997).

When the art in question is relatively simple, the opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied rigorously. McGinley v. Franklin Sports, Inc., 60 U.S.P.Q.2D 1001, 262 F.3d 1339, 1352 (Fed. Cir. 2001). In each case the factual inquiry whether to combine references must be thorough and searching. Id., at 1352 - 53.

Finally, during examination, claims are given their broadest reasonable interpretation consistent with the specification. In re Hyatt, 54 U.S.P.Q.2D 1664, 211 F.3d 1367 (Fed. Cir. 2000). The "PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description

contained in applicant's specification." In re Morris, 44 U.S.P.Q.2D 1023, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997).

3.2 Substantial Evidence is Required of All Factual Findings

In a determination of obviousness, factual findings as to scope and content of the prior art, level of ordinary skill in the art, differences between the claimed invention and the prior art, and secondary considerations of nonobviousness must be supported by substantial evidence. Novamedix Distrib. Ltd. v. Dickinson, 175 F. Supp. 2d 8, 9 (D.D.C. 2001).

"[D]eficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'" In re Zurko, 59 U.S.P.Q.2D 1693, 258 F.3d 1379, 1385 (Fed. Cir. 2001); In re Lee, 61 U.S.P.Q.2D 1430, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

Moreover, where a conclusion of obviousness rests on the prior knowledge in the field of the invention, then that "[p]rior knowledge in the field of the invention must be supported by tangible teachings of reference materials." Cardiac Pacemakers, Inc. v St. Jude Medical, Inc., 381 F.3d 1371 (Fed. Cir. 2004).

3.3. Absent Substantial Evidence, No Prima Facie Case Exists

To reject claims in an application under Section 103, an examiner must show an unrebutted *prima facie* case of obviousness. In re Rouffet, 47 U.S.P.Q.2D 1453, 149 F.3d 1350, 1355 (Fed. Cir. 1998).

The initial burden of presenting a *prima facie* case of obviousness is upon the examiner. In re Oetiker, 24 U.S.P.Q.2D 1443, 977 F.2d 1443, 1445 (Fed. Cir. 1992). If the examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. In re Rijckaert, 28 U.S.P.Q.2D 1955, 9 F.3d 1531, 1532 (Fed. Cir. 1993); Novamedix Distrib. Ltd. v. Dickinson, 175 F. Supp. 2d 8, 9 (D.D.C. 2001).

If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent. In re Oetiker, 24 U.S.P.Q.2D 1443, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

3.4. **Group I: Claims 70, 76 and 78**

Independent method claim 70 contains the following limitations:

generating, by a computer, a certificate identifier corresponding to an account identifier that is associated with a financial account, said certificate identifier being different from said account identifier;

producing a gift certificate including thereon said certificate identifier, said gift certificate not including said account identifier; and

distributing said gift certificate to an owner of said financial account.

Independent claim 76 pertains to a system for issuing a gift certificate that includes *computer means, means for producing a gift certificate and means for distributing a gift certificate*, and that incorporates the above limitations. Independent claim 78 recites a computer-readable storage medium encoded with processing instructions for implementing a method that directs a computer to perform the steps listed above. Consequently, the arguments below concerning claim 70 are equally applicable to claims 76 and 78 and will not be repeated for the sake of brevity.

Appellants submit that the rejection of the claims of GROUP I is flawed because the Examiner has not made a *prima facie* case of obviousness:

- the Examiner has not established substantial evidence of record to support a finding that the cited references, either alone or in combination, teach or suggest (i) *generating, by a computer, a certificate identifier corresponding to an account identifier that is associated with a financial account, said certificate identifier being different from said account identifier*; and (ii) *producing a gift certificate including thereon said certificate identifier, said gift certificate not including said account identifier*;
- the Examiner has failed to provide substantial evidence for a motivation to combine or modify the references in the manner suggested; and
- none of the references, alone or in combination, teach or suggest the claim limitations of (i) *generating, by a computer, a certificate identifier corresponding to an account identifier that is associated with a financial account, said certificate identifier being different*

from said account identifier; (ii) producing a gift certificate including thereon said certificate identifier, said gift certificate not including said account identifier; and (iii) distributing said gift certificate to an owner of said financial account. (emphasis added)

3.4.1. The References Do Not Disclose All the Limitations of the GROUP I Claims 70, 76 and 78

3.4.1.1. Examiner's Asserted Factual Findings

As best understood by Appellants, the Examiner asserts the following to be true:

Gregory discloses all of the features of each of Claims **70, 76 and 78** except said gift certificate not including said account identifier; and

Foreman discloses said gift certificate not including said account identifier. [Final Office Action, paragraph 4, pages 2-3].

The Examiner cites Column 5, lines 64-67 and Column 6, lines 1-17 of Gregory to support her proposition that this reference discloses *generating, by a computer, a certificate identifier corresponding to an account identifier that is associated with a financial account, said certificate identifier being different from said account identifier.* Gregory, at Column 5, lines 64-67, and at Column 6, lines 1-17 recites:

Pre-printed money order forms include parameters as described above such as money order number, financial institution name, and account number. These fixed parameters which have been pre-printed on money order forms in known systems, may now be printed on blank paper at the remote data processing system by the present invention. In addition to printing these parameters, in accordance with the present invention, the variable parameters such as amount and date are also printed on the paper

simultaneously with the money order number, financial institution name and account number. The system described above can also be used to print gift certificates with minimal additions.

After a money order or gift certificate is printed, the parameters are recorded in a log. The number will be associated with the date and amount. In this manner, problems associated with known systems may be avoided. In the present invention, utilizing blank paper instead of pre-printed forms, money order numbers are printed and recorded simultaneously with the date and amount. Therefore, no particular sequence of money order number is expected or necessary.

The Examiner also cites Column 6, lines 31-39 to support her accusation that Gregory teaches *producing a gift certificate including thereon said certificate identifier, said gift certificate not including said account identifier*. Gregory, at Column 6, lines 31-39 recites:

In this system, fixed parameters necessary for printing payroll checks may be automatically downloaded to the remote data processing station by the data processing system or central server at the home office. These parameters include the employee's name, date, amount, financial institution name, facsimile signature and account number. In this manner, checks may be printed remotely at the store location, thus eliminating any need for delivering the checks overnight.

With regard to Foreman, the Examiner asserts: "Foreman teaches, said gift certificate not including said account identifier (col. 7, lines 3-19, fig. 9, and fig. 10 –shows security code numbers for the money order)." [Final Office Action, page 4, lines 1-2].

Foreman, at Column 7, lines 3-19 recites:

Most money order agents work with vendors who provide goods and services to the agent on a regular basis. Oftentimes for convenience and accounting purposes, vendor payments will be made with money orders. When a typical money order is purchased it is printed with a "dollar" amount and the payee line is left blank to be filled in by the purchaser. In the case of vendor payments, a blank payee line could result in the unauthorized negotiation of the money order by the vendor's representative. To prevent such unauthorized negotiation a plurality of

vendor names may be stored in the memory 18 associated with the terminal 12. Thus, when a money order is issued for a vendor payment, the appropriately coded vendor name is downloaded to the memory 40 associated with the printer 20 and is printed on the payee line 80 on the blank money order form 24, as shown in FIG. 9.

And as indicated at Column 4, lines 31-34:

FIG. 9 is a top view of the back side of a series of blank money order forms illustrating the placement of timing marks on the back of every fourth money order form

Further, as indicated at Column 4, lines 35-37:

FIG. 10 is a top view of a printed money order form illustrating the printing of a logo and vendor's name and the payee blank on the preprinted form

3.4.1.2 The Examiner's Evidence is Flawed and is Not Substantial Evidence

Appellants respectfully assert that nothing in the cited portions of Gregory reproduced above teaches or suggests *generating, by a computer, a certificate identifier corresponding to an account identifier that is associated with a financial account, said certificate identifier being different from said account identifier.*

Appellants acknowledge that the GROUP I claims expressly recite that the generated *certificate identifier* is different from the account identifier. Appellants also readily admit that The GROUP I claims also require *producing a gift certificate* that includes the *certificate identifier, said gift certificate not including said account identifier.* The Examiner admits on page 2 of the Final Office Action that Gregory does not teach a gift certificate that does not include an account identifier. *Ipsa facto, Gregory* cannot possibly teach *generating, by a computer, a certificate*

identifier according to the present invention, because the GROUP I claims require the certificate identifier to be *different* from the account identifier.

Appellants also respectfully submit that Gregory fails to suggest or teach *distributing said gift certificate to an owner of said financial account* as recited by the GROUP I claims. In fact, Gregory teaches away from such a method by teaching processes and systems that, for example, print payroll checks on demand for a manager at a store location for distribution to the store employees, which likely includes the manager himself (See Gregory, Column 6, lines 51-55). It does not appear that the store manager and the employees are the “owner of the financial account”.

Furthermore, with regard to the Examiner’s assertion that Foreman teaches a gift certificate that does not include an account identifier, the Appellants respectfully assert that nothing in the cited portion of Foreman at Column 7, in Fig. 9, or in Fig. 10 has anything to do with any “security code numbers for the money order.” Fig. 9 is described as “the back side of a series of blank money order forms.” In addition, no description of Fig. 10 suggests “security code numbers.”

Appellants have gone further and considered all of Foreman. There is some description in Column 7 with respect to Fig. 8 and mention of a “security font 100” (lines 31-60), but this description does not appear to have anything to do with a “security code number”, or have anything to do with producing a gift certificate without an account identifier.

The terms “security code,” “host security code,” “agent security code,” and “security code level,” are used throughout Foreman, including in the Abstract, the Summary of the Invention, and particularly in Column 8 (lines 5-57). As Appellants understand Foreman, various types of “security

codes" may be required in the Foreman system for "purposes of internal control and operator security," to perform functions from the host computer 48 (after entering a host security code from the host computer), and to perform other various functions and reprogram fields (through use of an agent security code). Appellants respectfully submit that these "security codes" and "security levels" do not suggest anything remotely related to financial accounts, identifiers for such accounts, or what types of information are or are not included on a produced gift certificate.

Thus, even if the Examiner is correct that Foreman shows "security code numbers for the money orders," that teaching would not provide for the feature the Examiner concedes is missing from Gregory: *said gift certificate not including said account identifier.*

In view of the above remarks, Appellants respectfully assert that the Examiner has failed to establish substantial evidence that all of the features of any of the GROUP I claims **70, 76 and 78** were known. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of the Group I claims.

3.4.2 No Motivation to Combine the Cited References

The Examiner must also show

- (i) that the prior art of record provides substantial evidence of a teaching, suggestion, or motivation to make the proposed combination or modification of the asserted teachings of the prior art, and
- (ii) that this properly supported combination or modification would provide for the specific features of the claimed invention.

3.4.2.1 Examiner's Asserted Factual Findings

The Examiner asserts: “It would have been obvious...to have [sic] gift certificate not include an account identifier and to modify in [sic] Gregory because such a modification would allow Gregory to have an internal controller and operator security that can be programmed for varying security levels.” [Final Office Action, page 3, lines 2-6].

3.4.2.2 The Examiner's Evidence is Not Substantial Evidence

The Examiner did not cite any particular portion of Foreman in support of the asserted motivation to provide specifically for said gift certificate not including said account identifier. Appellants were able to identify the following sentence in Foreman: “For purposes of internal control and operator security, the control terminal 12 and printer 20 are controlled and the memories 18 and 40 associated therewith may be reprogrammed at varying security levels.” [Column 8, lines 5-6].

No rationale was provided as to how reprogramming at “varying security levels,” “security codes,” or generally securing access of individuals to a money order dispensing system in any way suggests modifying Gregory to provide specifically for said gift certificate not including said account identifier as recited in the GROUP I claims. Moreover, the operational security concerns addressed by the “security codes” of Foreman do not appear to have anything to do with said gift certificate not including said account identifier, or to even concern financial accounts, identifiers corresponding to certificate identifiers, or what types of information are or are not included on a produced gift certificate. Accordingly, the asserted motivation cannot suggest the desirability of the particular feature the

Examiner concedes is missing in Gregory: *said gift certificate not including said account identifier.*

Furthermore, the Appellants respectfully assert that one skilled in the art would not combine Gregory and Foreman in the manner suggested by the Examiner because Gregory teaches away from such a combination. In particular, a primary object of Gregory is to provide a method and system for automatically creating a financial instrument by using blank paper in order to avoid sequencing and transaction log problems of the prior art. (See Gregory, Column 3, lines 27-30, and Column 4, lines 17-38). In stark contrast, the system disclosed by Foreman can only work with fan-folded money order forms that contain both pre-printed serial numbers and pre-printed timing marks. Appellants respectfully assert that the serial numbers and timing marks are an essential component of Foreman's invention that are used to prevent fraud (See Foreman, Column 6, lines 25-47), and thus these features cannot be discarded. Appellants submit that Foreman is exactly the type of prior art system that is made obsolete by the system disclosed in Gregory. Consequently, one skilled in the art would not combine these two references.

For the reasons set forth above, Appellants respectfully assert that the Examiner has failed to establish substantial evidence of a proper motivation to combine or modify the Gregory system to provide for *said gift certificate not including said account identifier*. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of any of the GROUP I claims **70, 76 and 78.**

3.4.2.3. No Showing of Level of Ordinary Skill in the Art

Appellants submit that the Examiner has also failed to resolve (or even identify) the level of ordinary skill in the pertinent art as required by the Supreme Court. Graham v. John Deere Co., 383 U.S. 1, 17 (1966). Having failed to resolve the level of ordinary skill in the art in the record, Appellants asseverate that the Examiner is unable to determine what “would have been obvious to one of ordinary skill in the art” at the time of the invention.

In summary, the Examiner has not established a *prima facie* case of obviousness with respect to the claims of GROUP I because the Examiner has not shown (i) that all of the limitations of any claim of GROUP I are taught by the references of record, alone or in combination; nor (ii) a motivation in the prior art of record to combine the references in any manner that renders the claims of GROUP I obvious. The rejection fails for at least this reason.

3.5. Group II: Claims 73, 77 and 79

Independent method claim 73 contains the following limitations:

generating, by a computer, a certificate identifier corresponding to an account identifier that is associated with a financial account, said certificate identifier being different from said account identifier;

producing a gift certificate including thereon said certificate identifier, said gift certificate not including said account identifier; and

distributing said gift certificate to a recipient.

Independent claim 77 pertains to a system for issuing a gift certificate that includes *computer means, means for producing a gift certificate and means for distributing a gift certificate* and that incorporates the above limitations. Independent claim 79 recites a computer-readable storage medium encoded with processing instructions for implementing a method that directs a computer to perform the steps listed above. Consequently, the arguments below concerning claim 73 are equally applicable to claims 77 and 79 and will not be repeated for the sake of brevity.

Appellants submit that the rejection of the claims of GROUP II is flawed because the Examiner has not made a *prima facie* case of obviousness:

- the Examiner has not established substantial evidence of record to support a finding that the cited references, either alone or in combination, teach or suggest (i) *generating, by a computer, a certificate identifier corresponding to an account identifier that is associated with a financial account, said certificate identifier being different from said account identifier; and*
(ii) *producing a gift certificate including thereon said certificate identifier, said gift certificate not including said account identifier;*

- the Examiner has failed to provide substantial evidence for a motivation to combine or modify the references in the manner suggested; and
- none of the references, alone or in combination, teach or suggest the claim limitations of (i) *generating, by a computer, a certificate identifier corresponding to an account identifier that is associated with a financial account, said certificate identifier being different from said account identifier*; (ii) *producing a gift certificate including thereon said certificate identifier, said gift certificate not including said account identifier*; and (iii) *distributing said gift certificate to an owner of said financial account*. (emphasis added)

3.5.1 The References Do Not Disclose All the Limitations of the GROUP II Claims 73, 77 and 79

3.5.1.1. Examiner's Asserted Factual Findings

As discussed above with respect to GROUP I, as best understood by Appellants, the Examiner asserts the following to be true:

Gregory discloses all of the features of each of Claims 73, 77 and 79 except *said gift certificate not including said account identifier*; and

Foreman discloses *said gift certificate not including said account identifier*.

[Final Office Action, paragraph 4, pages 2-3].

As also discussed above with regard to the GROUP I claims, the Examiner cites Column 5, lines 64-67 and Column 6, lines 1-17 of Gregory to support her proposition that this reference discloses *generating, by a*

computer, a certificate identifier corresponding to an account identifier that is associated with a financial account, said certificate identifier being different from said account identifier. The cited sections of Gregory appear above in Section 3.4.1.1. and therefore will not be repeated here for purposes of brevity.

The Examiner also cited Column 6, lines 31-39 to support her accusation that Gregory teaches *producing a gift certificate including thereon said certificate identifier, said gift certificate not including said account identifier.* This cited portion of Gregory also appears above in Section 3.4.1.1. and therefore will not be repeated here for purposes of brevity.

With regard to Foreman, the Examiner asserts: “Foreman teaches, said gift certificate not including said account identifier (col. 7, lines 3-19, fig. 9, and fig. 10 –shows security code numbers for the money order).” [Final Office Action, page 4, lines 1-2]. Again, this cited portion of Foreman appears above in Section 3.4.1.1. and thus for purposes of brevity will not be repeated here.

3.5.1.2 The Examiner’s Evidence is Flawed and is Not Substantial Evidence

Appellants respectfully assert that nothing in the cited portions of Gregory reproduced above teaches or suggests *generating, by a computer, a certificate identifier corresponding to an account identifier that is associated with a financial account, said certificate identifier being different from said account identifier.*

Appellants acknowledge that the GROUP II claims expressly recite that the generated *certificate identifier* is different from the account identifier. Appellants also readily admit that The GROUP II claims also require *producing a gift certificate* that includes the *certificate identifier*, said gift certificate not including said account identifier. The Examiner admits on page 2 of the Final Office Action that Gregory does not teach a gift certificate that does not include an account identifier. *Ipsa facto*, Gregory cannot possibly teach *generating, by a computer, a certificate identifier* according to the present invention, because the GROUP II claims require the certificate identifier to be *different* from the account identifier.

Furthermore, with regard to the Examiner's assertion that Foreman teaches a gift certificate that does not include an account identifier, the Appellants respectfully assert that nothing in the cited portion of Foreman at Column 7, in Fig. 9, or in Fig. 10 has anything to do with any "security code numbers for the money order." Fig. 9 is described as "the back side of a series of blank money order forms." In addition, no description of Fig. 10 suggests "security code numbers."

As explained above in Section 3.4.1.2, Appellants considered all of Foreman and could not find any reference to a "security code number", or any disclosure concerning producing a gift certificate without an account identifier. For the reasons set forth above, Appellants respectfully reassert that the "security codes" and "security levels" of Foreman do not suggest anything remotely related to financial accounts, identifiers for such accounts, or what types of information are or are not included on a produced gift certificate.

Accordingly, even if the Examiner is correct that Foreman shows “security code numbers for the money orders,” that teaching would not provide for the feature the Examiner concedes is missing from Gregory: *said gift certificate not including said account identifier.*

In view of the above remarks, Appellants respectfully assert that the Examiner has failed to establish substantial evidence that all of the features of any of the GROUP II claims **73, 77 and 79** were known. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of the Group II claims.

3.5.2. No Motivation to Combine the Cited References

The Examiner must also show

- (i) that the prior art of record provides substantial evidence of a teaching, suggestion, or motivation to make the proposed combination or modification of the asserted teachings of the prior art, and
- (ii) that this properly supported combination or modification would provide for the specific features of the claimed invention.

3.5.2.1 Examiner’s Asserted Factual Findings

The Examiner asserts: “It would have been obvious...to have [sic] gift certificate not include an account identifier and to modify in [sic] Gregory because such a modification would allow Gregory to have an internal controller and operator security that can be programmed for varying security levels.” [Final Office Action, page 3, lines 2-6].

3.5.2.2 The Examiner's Evidence is Not Substantial Evidence

The Examiner did not cite any particular portion of Foreman in support of the asserted motivation to provide specifically for *said gift certificate not including said account identifier*. Appellants were able to identify the following sentence in Foreman: “For purposes of internal control and operator security, the control terminal 12 and printer 20 are controlled and the memories 18 and 40 associated therewith may be reprogrammed at varying security levels.” [Column 8, lines 5-6].

As discussed above in Section 3.4.2.2., no rationale was provided as to how reprogramming at “varying security levels,” “security codes,” or generally securing access of individuals to a money order dispensing system in any way suggests modifying Gregory to provide specifically for *said gift certificate not including said account identifier*. Moreover, the operational security concerns addressed by the “security codes” of Foreman do not appear to have anything to do with *said gift certificate not including said account identifier*, or to even concern financial accounts, identifiers corresponding to certificate identifiers, or what types of information are or are not included on a produced gift certificate. Accordingly, the asserted motivation cannot suggest the desirability of the particular feature the Examiner concedes is missing in Gregory: *said gift certificate not including said account identifier*.

Furthermore, as also argued above, the Appellants respectfully assert that one skilled in the art would not combine Gregory and Foreman in the manner suggested by the Examiner because Gregory teaches away from such a combination. A primary object of Gregory is to provide a method and system for automatically creating a financial instrument by using blank

paper in order to avoid sequencing and transaction log problems of the prior art. (See Gregory, Column 3, lines 27-30, and Column 4, lines 17-38). In stark contrast, the system disclosed by Foreman can only work with fan-folded money order forms that contain both pre-printed serial numbers and pre-printed timing marks. Appellants respectfully reassert that the serial numbers and timing marks are an essential component of Foreman's invention that are used to prevent fraud (See Foreman, Column 6, lines 25-47), and thus these features cannot be discarded. Consequently, Appellants proffer that Foreman is exactly the type of prior art system that is made obsolete by the system disclosed in Gregory. For at least this reason, one skilled in the art would not combine these references.

For the reasons set forth above, Appellants respectfully assert that the Examiner has failed to establish substantial evidence of a proper motivation to combine or modify the Gregory system to provide for *said gift certificate not including said account identifier*. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of any of the GROUP II claims **73, 77 and 79**.

3.5.2.3. No Showing of Level of Ordinary Skill in the Art

Appellants submit that the Examiner has also failed to resolve (or even identify) the level of ordinary skill in the pertinent art as required by the Supreme Court. Graham v. John Deere Co., 383 U.S. 1, 17 (1966). Having failed to resolve the level of ordinary skill in the art in the record, Appellants asseverate that the Examiner is unable to determine what "would have been obvious to one of ordinary skill in the art" at the time of the invention.

In summary, the Examiner has not established a *prima facie* case of obviousness with respect to the claims of GROUP II because the Examiner has not shown (i) that all of the limitations of any claim of GROUP II are taught by the references of record, alone or in combination; nor (ii) a motivation in the prior art of record to combine the references in any manner that renders the claims of GROUP II obvious. The rejection fails for at least this reason.

3.6. Group III: Claims 71 and 74

GROUP III includes dependent claims **71 and 74**. Claim **71** depends on claim **70**, and provides *wherein the financial account identifier cannot be discerned from the gift certificate identifier by a third party*. Claim **74** recites the same limitation but depends from claim **73**, and thus the arguments set forth below concerning claim **71** are equally applicable to claim **73** and will not be repeated for the sake of brevity.

The 35 U.S.C. §103(a) rejection of the claims of GROUP III is flawed because the Examiner has not made a *prima facie* case of unpatentability of any claim of GROUP I or of GROUP II. Specifically, the Examiner has not shown that each of the claim limitations of independent claims **70 and 73** is taught or suggested by the prior art. Further, as explained above, the Examiner has not provided a proper motivation to combine the references in the manner suggested.

Further, no claim of GROUP III can be deemed obvious in light of the references of record, alone or in any combination, because the cited

references, alone or in any combination, cannot be interpreted in a manner that would disclose or suggest the limitations of any pending claim.

3.6.1 Gregory Does Not Disclose All the Limitations of the GROUP III Claims 71 and 74

3.6.1.1. Examiner's Asserted Factual Findings

The Examiner cites Column 6, lines 18-22 and lines 31-39, and Column 8, lines 45-53 for her assertion that, with respect to claims 71 and 74, that: "Gregory teaches the method of claim 70 wherein the financial account identifier cannot be discerned from the gift certificate identifier by a third party." [Final Office Action, paragraph 4, page 3].

Gregory, at Column 6, lines 18-22 and lines 31-39 recites:

Only those authorized employees with a valid password may print the payroll checks. On the day specified for paying the store employees, the authorized employee may utilize the remote data processing system to print payroll checks on the blank paper loaded into the printer.

...
In this system, fixed parameters necessary for printing payroll checks may be automatically downloaded to the remote data processing station by the data processing system or central server at the home office. These parameters include the employee's name, date, amount, financial institution name, facsimile signature and account number. In this manner, checks may be printed remotely at the store location, thus eliminating any need for delivering the checks overnight.

Gregory, at Column 8, lines 45-53, recites:

In known systems, data processing systems capable of printing money order or checks must be supplied with pre-printed form which includes a first plurality of parameters. The first plurality of parameters may include the financial institution identification number, account number, check or sequence number, facsimile signature or other information. This includes any information

related to a particular instrument which remains constant from transaction to transaction.

3.6.1.2 The Examiner's Evidence is Flawed and is Not Substantial Evidence

Appellants assert that the cited portions of Gregory quoted above suggest nothing about whether any type of identifier (much less an identifier that identifies an account identifier) may be discerned from a certificate identifier by a third party. To the contrary, as these portions of Gregory teach printing account numbers on the instruments, the Examiner's evidence teaches away from the claimed subject matter of Claims 71 and 74 as a whole, which requires that an account identifier associated with a financial account is not included on a produced gift certificate.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of any of claims of GROUP III.

3.6.2 No Motivation to Combine the Cited References

As explained above in Sections 3.4.2 and 3.5.2, the Examiner has failed to show (i) that the prior art of record provides substantial evidence of a teaching, suggestion, or motivation to make the proposed combination or modification of the asserted teachings of the prior art, and (ii) that this properly supported combination or modification would provide for the specific features of the claimed invention. Appellants herein incorporate the arguments made in Sections 3.4.2. and 3.5.2. by reference in their entirety herein, and accordingly reassert that one skilled in the art would not have been motivated to combine the Gregory and Foreman references.

Accordingly, the Examiner has not presented a *prima facie* case of obviousness of the claims of GROUP III.

3.6.2.1. No Showing of Level of Ordinary Skill in the Art

As presented above in Section 3.4.2.3., Appellants submit that the Examiner has also failed to resolve (or even identify) the level of ordinary skill in the pertinent art as required by the Supreme Court. Graham v. John Deere Co., 383 U.S. 1, 17 (1966). Having failed to resolve the level of ordinary skill in the art in the record, Appellants asseverate that the Examiner is unable to determine what “would have been obvious to one of ordinary skill in the art” at the time of the invention.

In summary, the Examiner has not established a *prima facie* case of obviousness with respect to the claims of GROUP III because the Examiner has not shown (i) that all of the limitations of any claim of GROUP III are taught by the references of record, alone or in combination; nor (ii) a motivation in the prior art of record to combine the references in any manner that renders the claims of GROUP III obvious. The rejection fails for at least this reason.

3.7. Group IV: Claims 72 and 75

GROUP IV includes dependent claims **72 and 75**. Claim **72** depends on claim **70**, and includes the further steps of:

*receiving an indication of a gift certificate redemption; and
updating stored account data to reflect the redemption.*

Claim 75 recites the same limitations but depends from claim 73, and thus the arguments set forth below concerning claim 72 are equally applicable to claim 75 and will not be repeated for the sake of brevity.

The 35 U.S.C. §103(a) rejection of the claims of GROUP IV is flawed because the Examiner has not made a *prima facie* case of unpatentability of any claim of GROUP I or of GROUP II. Specifically, the Examiner has not shown that each of the claim limitations of independent claims 70 and 73 is taught or suggested by the prior art. Further, as explained above, the Examiner has not provided a proper motivation to combine the references in the manner suggested.

Further, no claim of GROUP IV can be deemed obvious in light of the references of record, alone or in any combination, because the cited references, alone or in any combination, cannot be interpreted in a manner that would disclose or suggest the limitations of any pending claim.

3.7.1 Gregory Does Not Disclose All the Limitations of the GROUP IV Claims 72 and 75

3.7.1.1. Examiner's Asserted Factual Findings

The Examiner cites Gregory, Column 9, lines 50-59, and Column 10, lines 46-55 for her assertions, with respect to claims 72 and 75, that: “Gregory teaches, The (sic.) method of claim 70, further including the steps of: receiving an indication of a gift certificate redemption (col. 9, lines 50-59); and updating stored account data to reflect the redemption (col. 10, lines 46-55).” [Final Office Action, paragraph 4, page 3].

Gregory, at Column 9, lines 50-59 recites:

Printer 18 must be fitted with a conventional MICR toner cartridge to enable a bank clearing house to determine that the printed check is valid and automatically process the check. The MICR toner contains a specified minimum percentage of a magnetic medium. The magnetic medium is required for automatic scanning of printed checks. The magnetically responsive characters are printed at the bottom of the instrument. The preferred format for the MICR encoded characters is in a grid with 37 rows down and 36 columns wide.

Gregory, at Column 10, lines 46-55, recites:

Referring again to block 68, if a determination is made that the user wishes to print a money order, the process passes to block 88 of FIG. 3B as depicted through block 78. Each time a money order is printed, remote processing station 14 writes a description of the money order into the current money order log. The description includes the date and time of purchase, the store where the money order is purchased, the amount of the money order, the fee amount, and the check number.

3.7.1.2 The Examiner's Evidence is Flawed and is Not Substantial Evidence

Appellants cannot understand how the cited portion of Gregory quoted above that describes fitting a printer with a MICR toner cartridge has anything whatsoever to do with *receiving an indication of a gift certificate redemption* as recited in the GROUP IV claims. Furthermore, the portion of Gregory cited above at Column 10, lines 46-55 describes how a current money order log is updated when a money order is printed, and does not teach or suggest *updating stored account data to reflect the redemption* as recited in the GROUP IV claims. In view of the above comments, Appellants assert that these cited portions of Gregory fail to support the Examiner's rejections.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of any of claims of GROUP IV.

3.7.2 No Motivation to Combine the Cited References

As explained above in Sections 3.4.2 and 3.5.2, the Examiner has failed to show (i) that the prior art of record provides substantial evidence of a teaching, suggestion, or motivation to make the proposed combination or modification of the asserted teachings of the prior art, and (ii) that this properly supported combination or modification would provide for the specific features of the claimed invention. Appellants herein incorporate the arguments made in Sections 3.4.2. and 3.5.2. by reference in their entirety herein, and accordingly reassert that one skilled in the art would not have been motivated to combine the Gregory and Foreman references.

Accordingly, the Examiner has not presented a *prima facie* case of obviousness of the claims of GROUP IV.

3.7.2.1. No Showing of Level of Ordinary Skill in the Art

As presented above in Section 3.4.2.3., Appellants submit that the Examiner has also failed to resolve (or even identify) the level of ordinary skill in the pertinent art as required by the Supreme Court. Graham v. John Deere Co., 383 U.S. 1, 17 (1966). Having failed to resolve the level of ordinary skill in the art in the record, Appellants asseverate that the Examiner is unable to determine what “would have been obvious to one of ordinary skill in the art” at the time of the invention.

In summary, the Examiner has not established a *prima facie* case of obviousness with respect to the claims of GROUP IV because the Examiner

has not shown (i) that all of the limitations of any claim of GROUP IV are taught by the references of record, alone or in combination; nor (ii) a motivation in the prior art of record to combine the references in any manner that renders the claims of GROUP IV obvious. The rejection fails for at least this reason.

3.8. Group V: Claim 81

Independent claim 81 includes the following limitations:

producing a gift certificate in which

(i) the gift certificate includes a sixteen-digit certificate identifier determined by a computer,

(ii) in which the included sixteen-digit certificate identifier is an alias of an account identifier

(iii) in which the account identifier identifies a financial account, and

(iv) in which the account identifier identifies a credit card account.

3.8.1. The References Do Not Disclose All the Limitations of Independent Claim 81

3.8.1.1. Examiner's Asserted Factual Findings

With regard to independent claim 81, as best understood by Appellants, the Examiner asserts the following to be true:

Gregory discloses all of the features of claim 81 except “the gift certificate including a sixteen-digit identifier, in which the sixteen-digit certificate [sic] is an alias of an account identifier that identifies a financial account”; and

Foreman discloses “the gift certificate including a sixteen-digit identifier, in which the sixteen-digit certificate [sic] is an alias of an account identifier that identifies a financial account.” [Final Office Action, paragraph 4, pages 3-4].

The Examiner asserts: “Foreman teaches, the gift certificate including a sixteen-digit identifier (col. 7, line 31 – col. 8, line 58), in which the sixteen-digit certificate [sic] is an alias of an account identifier that identifies a financial account (col. 8, lines 16-40).” [Final Office Action, page 4].

The text of Foreman, Column 7, line 31 to Column 8, line 58 is as follows:

As a further security measure, the numeric amount 82 of the money order is printed on the form 24 in a specially programmed security font 100 as shown in FIG. 8. The font 100 includes diagonal lineations 102 between asterisks 104 used to fill space not occupied by numerals representing dollar amounts. The diagonal lineations 102 also extend between the last appearing spacing asterisk 104 and a negatively printed "\$" 106 which is defined not by printing the "\$" 106 but by printing the background surrounding the "\$" 106. Thus, where the other printed indicia appears dark on a light background the "\$" 106 appears light on a dark background immediately surrounding the "\$" 106.

Diagonal lineation 102 separates the "\$" 106 from the first numeral 108 of the dollar amount. The last numeral 108 of the dollar amount and the first numeral 110 representing the amount in cents is separated by a vertically printed abbreviation 112 of the word "dollars". The numerals 110 representing the amount in cents are approximately half the height of the numerals 108 representing the dollar amounts. Diagonal lineations 102 separate the numerals 110 representing the amount in cents and the area

immediately below each of the numerals 110 representing the amount in cents. Immediately following the last numeral 110 in the cent amount is a vertically printed abbreviation 114 of the word "cents". The various characters and configuration of the security font 100 are very difficult, if not impossible, to alter, thereby substantially reducing the risk of alteration of the dollar amount printed on the form.

Referring now to FIG. 9, in the event a particular agent wishes to print its logo 140 on the money order form 24, the logo 140 is downloaded from the host or agent computer to the control terminal 12, which in turn downloads the logo 140 to the memory 40 associated with printer 20 for printing on the money order form 24. Following the initial download to the memory 40 the logo resides in the memory 40 indefinitely. There is no need to transmit the logo or other routinely printed graphical or alphanumeric information during each transaction. This feature significantly decreases the printing time of the dispenser.

For purposes of internal control and operator security, the control terminal 12 and printer 20 are controlled and the memories 18 and 40 associated therewith may be reprogrammed at varying security levels. Many of the functions and operations of the money order dispenser 10 may be reprogrammed and controlled only from the host computer 48. A host security code which is contained within the operating program stored in the memory 18 associated with the control terminal 12 must be entered from the host computer 48 to perform functions flagged with a host level security code.

Various other functions may be performed and fields reprogrammed through use of an agent security code. As the security risk lessens, or the particular need to access a function becomes user specific, the security code required to access the particular function will vary. Thus, there are five levels of security codes, with various privileges assigned each security level as defined within the operating program contained in the memory of the control terminal 12.

The five security code levels include the host level, which may be accessed only by the host computer 48; the agent level, which may be accessed by the agent through the agent's computer 42, and in most situations the host computer 48; the store level which may be accessed through the keyboard 14 at the particular store location and which may in most cases be accessed through the agent and host level security codes. In addition to the store security code, a manager security code allows access to various functions and programmable fields through the keyboard 14 of the control terminal 12 in each particular store. The manager's security code is limited, however, to that particular store. The fifth level of security

code is the employee level having associated therewith the fewest number of privileges necessary for printing money orders.

The privileges associated with each security code level may be reprogrammed at varying levels of security, as defined in the program operating the control terminal 12. By way of example, an employee must enter an employee's security code before a money order will print. In the event an amount is entered into the control terminal 12 which exceeds a maximum transaction dollar limit for that particular location, a manager code must be entered to allow printing of the money order. A daily total dollar amount limit may only be reset at the host security level. Host phone numbers stored in the system which are used to dial the host computer to upload information to the host computer may be changed by host, agent, or at the store security level through the keyboard. Thus, the multilevel security codes further insure security of the money order dispenser 10 against tampering and issuance of counterfeit money orders.

3.8.1.2. The Examiner's Evidence is Flawed and is Not Substantial Evidence

Appellants assert that nothing in the cited portions of Foreman in Column 7 and / or in Column 8 reproduced above teaches an identifier (of any type) having sixteen digits.

There is no hint of a gift certificate including a sixteen-digit identifier.

There is no hint of an identifier that is an alias of another identifier.

There is no hint of an identifier that is an alias of another identifier that identifies a financial account.

Accordingly, Foreman does not suggest anything remotely related to producing a gift certificate that includes *a sixteen-digit identifier* that is *an alias of an account identifier that identifies a financial account* as recited by claim 81.

The Examiner has failed to establish substantial evidence that all of the features of claim 81 were known. Accordingly, the Examiner has failed

to establish a *prima facie* case of obviousness of GROUP V independent claim **81**.

3.8.2 No Motivation to Combine the Cited References

The Examiner must also show

(i) that the prior art of record provides substantial evidence of a teaching, suggestion, or motivation to make the proposed combination or modification of the asserted teachings of the prior art, and

(ii) that this properly supported combination or modification would provide for the specific features of the claimed invention

3.8.2.1 Examiner's Asserted Factual Findings

The Examiner asserts: “It would have been obvious...to have the gift certificate including a sixteen-digit identifier, in which the sixteen-digit certificate [sic] is an alias of an account identifier that identifies a financial account and to modify in [sic] Gregory to have because such a modification would allow Gregory to have a special program generated security numerical indicia defined by a printed character on an unprinted background.” [Final Office Action, page 4].

3.8.2.2. The Examiner's Evidence is not Substantial

The Examiner did not cite any particular portion of Foreman in support of the asserted motivation to provide specifically for a gift certificate identifier that is an alias of an account identifier that identifies a financial account. The cited portions of Column 7 and Column 8 of Foreman reproduced above discuss a “specially programmed security font 100 as

shown in FIG. 8.” [See Column 7, lines 31-34]. The special security font may involve a “negatively printed ‘\$’ 106 which is defined not by printing the ‘\$’ 106 but by printing the background surrounding the ‘\$’ 106.” [Column 7, lines 38-40]. However, it is unclear if these passages are what the Examiner is referring to as “special program generated security numerical indicia defined by a printed character on an unprinted background.”. If they are, the motivation proposed by the Examiner seems related to how the amount of the described money order is presented in a way that would make it difficult to alter the amount. [See, e.g., Column 7, lines 57-60 (“The various characters and configuration of the security font 100 are very difficult, if not impossible, to alter....”)].

The Examiner does not provide any rationale as to how the “security font,” or deterring alteration of printed numbers on a money order in general, would suggest modifying Gregory to provide specifically for *the gift certificate including a sixteen-digit certificate identifier...in which the sixteen-digit certificate identifier is an alias of an account identifier that identifies a financial account*, as recited in claim 81. The security font or “numerical indicia” do not appear to have anything to do with any of the following items:

- sixteen digits,
- an identifier of sixteen digits,
- a certificate identifier,
- a certificate identifier of sixteen digits,
- an alias of an account identifier,
- an alias of an account identifier that identifies a financial account, or

including on a produced gift certificate a sixteen-digit certificate identifier that is an alias of an account identifier that identifies a financial account.

Accordingly, the asserted motivation cannot suggest the desirability of the particular feature the Examiner concedes is missing in Gregory. The Appellants thus submit that the Examiner has failed to establish substantial evidence of a proper motivation to combine or modify the Gregory system to provide for *the gift certificate including a sixteen-digit certificate identifier...in which the sixteen-digit certificate identifier is an alias of an account identifier that identifies a financial account*. Consequently, the Examiner has failed to establish a *prima facie* case of obviousness of GROUP V claim 81.

3.8.2.3. No Showing of Level of Ordinary Skill in the Art

As presented above in Section 3.4.2.3., Appellants submit that the Examiner has also failed to resolve (or even identify) the level of ordinary skill in the pertinent art as required by the Supreme Court. Graham v. John Deere Co., 383 U.S. 1, 17 (1966). Having failed to resolve the level of ordinary skill in the art in the record, Appellants asseverate that the Examiner is unable to determine what “would have been obvious to one of ordinary skill in the art” at the time of the invention.

In summary, the Examiner has not established a *prima facie* case of obviousness with respect to claim 81 of GROUP V because the Examiner has not shown (i) that all of the limitations of claim 81 are taught by the references of record, alone or in combination; nor (ii) a motivation in the

prior art of record to combine the references in any manner that renders claim **81** obvious. The rejection fails for at least this reason.

3.9. Group VI: Claims 82 and 84

GROUP VI includes dependent claims **82 and 84**. Claim **82** depends on claim **81**, and recites *in which the gift certificate is for a single use*.

Claim **84** recites the same limitations but depends from claim **83**, and thus the arguments set forth below concerning claim **82** are equally applicable to claim **84** and will not be repeated for the sake of brevity.

The 35 U.S.C. §103(a) rejection of the claims of GROUP VI is flawed because the Examiner has not made a *prima facie* case of unpatentability of claim **81** (GROUP V), and as will be shown below, the Examiner has not made a *prima facie* case of unpatentability of claim **83** (GROUP VII). Specifically, the Examiner has not shown that each of the claim limitations of independent claims **81 and 83** is taught or suggested by the prior art. Further, the Examiner has not provided a proper motivation to combine the references in the manner suggested.

Further, no claim of GROUP VI can be deemed obvious in light of the references of record, alone or in any combination, because the cited references, alone or in any combination, cannot be interpreted in a manner that would disclose or suggest the limitations of any pending claim.

3.9.1 Gregory Does Not Disclose All the Limitations of the GROUP VI Claims 82 and 84

3.9.1.1. Examiner's Asserted Factual Findings

The Examiner cites Gregory, Column 5, line 56 to Column 6, line 16 for her assertions, with respect to claims 82 and 84, that: "Gregory teaches, in which (sic.) the gift certificate is for a single use." [Final Office Action, paragraph 4, page 4].

Gregory, at Column 5, line 56 to Column 6, line 16 recites:

According to the present invention, pre-printed forms are not needed in order to print financial instruments such as money orders and beer drafts. When a money order is to be printed, a valid password must first be entered. Thereafter, the employee may insert blank paper into the printer included within the remote data processing system and print a complete money order. All necessary parameters will be printed by the remote data processing system.

Pre-printed money order forms include parameters as described above such as money order number, financial institution name, and account number. These fixed parameters which have been pre-printed on money order forms in known systems, may now be printed on blank paper at the remote data processing system by the present invention. In addition to printing these parameters, in accordance with the present invention, the variable parameters such as amount and date are also printed on the paper simultaneously with the money order number, financial institution name and account number. The system described above can also be used to print gift certificates with minimal additions.

After a money order or gift certificate is printed, the parameters are recorded in a log. The number will be associated with the date and amount. In this manner, problems associated with known systems may be avoided. In the present invention, utilizing blank paper instead of pre-printed forms, money order numbers are printed and recorded simultaneously with the date and amount. Therefore, no particular sequence of money order number is expected or necessary.

3.9.1.2 The Examiner's Evidence is Flawed and is Not Substantial Evidence

Appellants respectfully assert that the above quoted passages of Gregory do not teach or suggest that *the gift certificate is for a single use* as recited in the GROUP VI claims. The cited portions have nothing to do with how many times a produced gift certificate may be used, much less that a gift certificate is for a single use. In contrast, the GROUP VI claims provide for wherein a produced gift certificate may be used only once (e.g., for one transaction by a recipient).

Thus, the cited passages of Gregory fail to support the Examiner's rejections, and accordingly the Examiner has failed to establish a *prima facie* case of obviousness of any of claims of GROUP VI.

3.9.2 No Motivation to Combine the Cited References

As explained above in Section 3.8.2, the Examiner has failed to show (i) that the prior art of record provides substantial evidence of a teaching, suggestion, or motivation to make the proposed combination or modification of the asserted teachings of the prior art, and (ii) that this properly supported combination or modification would provide for the specific features of the claimed invention. Appellants herein incorporate the arguments made in Section 3.8.2. by reference in their entirety herein, and additionally incorporate the arguments of Sections 3.4.2 and 3.5.2 in their entirety, in support of the assertion that one skilled in the art would not have been motivated to combine the Gregory and Foreman references.

Accordingly, the Examiner has not presented a *prima facie* case of obviousness of the claims of GROUP VI.

3.9.2.1. No Showing of Level of Ordinary Skill in the Art

As presented above in Section 3.4.2.3., Appellants submit that the Examiner has also failed to resolve (or even identify) the level of ordinary skill in the pertinent art as required by the Supreme Court. Graham v. John Deere Co., 383 U.S. 1, 17 (1966). Having failed to resolve the level of ordinary skill in the art in the record, Appellants asseverate that the Examiner is unable to determine what “would have been obvious to one of ordinary skill in the art” at the time of the invention.

In summary, the Examiner has not established a *prima facie* case of obviousness with respect to the claims of GROUP VI because the Examiner has not shown (i) that all of the limitations of any claim of GROUP VI are taught by the references of record, alone or in combination; nor (ii) a motivation in the prior art of record to combine the references in any manner that renders the claims of GROUP VI obvious. The rejection fails for at least this reason.

3.10. Group VII: Claim 83

Independent method claim 83 recites:

determining stored account data associated with a financial account, in which the account data includes an account identifier that identifies the financial account;

generating, by a computer, an alias identifier that provides an indirect link to the financial account, in which the alias identifier is different from the account identifier;

producing a gift certificate, the gift certificate including the alias identifier; and

providing the gift certificate to a recipient.

3.10.1. The References Do Not Disclose All the Limitations of Independent Claim 83

Specifically, no combination of the references could suggest all of the following features generally recited in claim 83:

- A. generating, by a computer, an alias identifier
 - in which
 - (i) the alias identifier provides an indirect link to a financial account
 - (ii) the financial account is identified by an account identifier
 - (iii) the alias identifier is different from the account identifier, and
- B. producing a gift certificate
 - in which the gift certificate includes the alias identifier described in (i)-(iii).

3.10.1.1 Examiner's Asserted Factual Findings

As Appellants best understand the rejection of independent claim 83, the Examiner asserts the following to be true:

Gregory discloses all of the features of Claim 83 except

“generating an alias identifier that provides an indirect link to the financial account, in which the alias identifier is different from the account identifier; producing a gift certificate, the gift certificate including the alias identifier; and providing the gift certificate to a recipient”; and

Foreman discloses “generating an alias identifier that provides an indirect link to the financial account, in which the alias identifier is different from the account identifier; producing a gift certificate, the gift certificate including the alias identifier; and providing the gift certificate to a recipient.”

[Final Office Action, pages 4-5].

Appellants dispute that Foreman discloses or suggests what the Examiner asserts, and do not necessarily agree that Gregory teaches all of the other features of claim 83. Arguments against the Examiner's assertions with respect to Gregory, however, are not presented herein for the sake of brevity, as such arguments are moot given the Examiner's failure to establish a *prima facie* case of obviousness (as explained below) even if those assertions are true.

The Examiner asserts that Foreman teaches all of the features missing from Gregory at Column 6, lines 26-47. [Final Office Action, page 5].

The text of Foreman at Column 6, lines 26-47 is provided below, with emphasis added:

Referring now to FIGS. 8 and 9, the blank money order forms 24 have a serial number 34 printed along a leading edge 36 of the form 24. A timing mark 38 is placed on the back of each money order form 24 falling in a **predetermined numbered sequence** in the fan folded bundle 50 of money order forms 24. **The corresponding serial number 34 of the particular money order form** bearing the timing mark must be evenly devisable by the number of the position location of the form in the bundle. In other words, if the timing mark 38 appears on every fourth money order form, the serial number 34 of the fourth money order form should be devisable by four. When the mark 38 is sensed by a sensing mechanism contained within the printer 20, the serial number 34 is read and a determination made whether it is devisable by the appropriate number. If not, printing of the money order will not occur and the sequence and alignment of the money order forms 24 must be checked by the operator of the dispenser 10. Thus, the timing marks 38 prevent the unauthorized removal of a blank money order form, which would result in an out of sequence serial number 34.

The Examiner also asserts: “a predetermined number sequence corresponding to the serial number of a particular money order form (gift certificate) which is considered an alias identifier.” [Final Office Action, page 5].

3.10.1.2 The Examiner’s Evidence is not Substantial Evidence

Appellants submit that the cited portion of Column 6 reproduced above is directed to a description of how the Foreman system ensures that blank money order forms are printed in the proper sequence, and that an unauthorized removal of a blank form could be detected. Furthermore, Appellants assert that the Examiner’s interpretation of this passage is strained beyond reason.

As we understand the Examiner’s use of Foreman, the Examiner relies on the following rationale:

- (i) blank money forms are provided in a “predetermined number sequence”; and
- (ii) each blank money form has a serial number 34;
and therefore it follows that
- (iii) each blank money form has a “predetermined number sequence” that is an “alias identifier” of its serial number.

Appellants vigorously dispute any such interpretation of Foreman. Clearly, the “predetermined number sequence” is the sequence of serial numbers “in the fan folded bundle 50 of money order forms 24.” There is no “alias” nature in this teaching of Foreman; the numbers are one and the same—sequential serial numbers. Appellants dispute the Examiner’s finding that a serial number in Foreman is an alias of, or corresponds to, itself.

Moreover, despite the Examiner’s conclusory statement, there is no support for the Examiner’s convenient assumption that “a predetermined number sequence...is considered an alias identifier” by one having ordinary skill in the art at the time of the invention. It is submitted that the Examiner has employed impermissible hindsight based on the present disclosure to justify the application of Foreman’s process for detecting unauthorized removal of blank money order forms against the claimed subject matter.

The Examiner has failed to establish substantial evidence that all of the features of claim 83 were known. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of GROUP VII independent claim 83.

3.10.2. No Motivation to Combine the Cited References

The Examiner must also show:

- (i) that the prior art of record provides substantial evidence of a teaching, suggestion, or motivation to make the proposed combination or modification of the asserted teachings of the prior art, and
- (ii) that this properly supported combination or modification would provide for the specific features of the claimed invention

3.10.2.1 Examiner's Asserted Factual Findings

The Examiner asserts: “It would have been obvious...to generate an alias identifier that provides an indirect link to the financial account, in which the alias identifier is different from the account identifier; and providing the gift certificate to a recipient and to modify in Gregory because such a modification would allow Gregory to have a predetermined number sequence corresponding to the serial number of a particular money order form (gift certificate” which is considered an alias identifier.” [Final Office Action, page 5].

3.10.2.2. The Examiner's Evidence is not Substantial

As explained above, the Examiner did not cite any particular portion of Foreman in support of the asserted motivation to provide specifically for generating, by a computer, an alias identifier that provides an indirect link to the financial account, in which the alias identifier is different from the account identifier; and for producing a gift certificate, the gift certificate including the alias identifier. In fact, the cited passages of Foreman in

Column 6 do not support the Examiner's interpretation of an alias identifier being generated. In particular, Appellants reassert the position that the Examiner's apparently strained finding, that a serial number in Foreman is an alias of itself, is clearly erroneous and / or unreasonable.

Moreover, there is absolutely no support for the Examiner's convenient assumption that "a predetermined number sequence...is considered an alias identifier" to one having ordinary skill in the art at the time of the invention. Appellants reassert that the Examiner has employed impermissible hindsight based on the present disclosure to justify applying Foreman's process for detecting unauthorized removal of blank money order forms against the claimed subject matter.

Accordingly, the asserted motivation cannot suggest the desirability of the particular feature the Examiner concedes is missing in Gregory. The Appellants thus submit that the Examiner has failed to establish substantial evidence of a proper motivation to combine or modify the Gregory system to provide for *the gift certificate including a sixteen-digit certificate identifier...in which the sixteen-digit certificate identifier is an alias of an account identifier that identifies a financial account*. Consequently, the Examiner has failed to establish a *prima facie* case of obviousness of GROUP V claim 81.

3.10.2.3. No Showing of Level of Ordinary Skill in the Art

As presented above in Section 3.4.2.3., Appellants also submit that the Examiner has failed to resolve (or even identify) the level of ordinary skill in the pertinent art as required by the Supreme Court. Graham v. John Deere Co., 383 U.S. 1, 17 (1966). Having failed to resolve the level of ordinary

skill in the art in the record, Appellants asseverate that the Examiner is unable to determine what “would have been obvious to one of ordinary skill in the art” at the time of the invention.

In summary, the Examiner has not established a *prima facie* case of obviousness with respect to claim **83** of GROUP VII because the Examiner has not shown (i) that all of the limitations of claim **83** are taught by the references of record, alone or in combination; nor (ii) a motivation in the prior art of record to combine the references in any manner that renders claim **83** obvious. The rejection fails for at least this reason.

3.11. Group VIII: Claim 85

GROUP VIII includes dependent claim **85**. Claim **85** depends on independent claim **83**, and provides *in which the gift certificate does not include the account identifier*.

The 35 U.S.C. §103(a) rejection of the GROUP VIII claim **85** is flawed at least because the Examiner has not made a *prima facie* case of unpatentability of claim **83** (GROUP VII). Specifically, the Examiner has not shown that each of the claim limitations of independent claim **83** is taught or suggested by the prior art. Further, as explained above, the Examiner has not provided a proper motivation to combine the references in the manner suggested.

Further, claim **85** cannot be deemed obvious in light of the references of record, alone or in any combination, because the cited references, alone or in any combination, cannot be interpreted in a manner that would disclose or suggest the limitations of any pending claim.

3.11.1 The Cited Art Does Not Disclose the Limitation of Claim 85

3.11.1.1. Examiner's Asserted Factual Findings

The Examiner states: "With respect to claim 85, this dependent claim is rejected for the similar rationale as given above for claims 70, 73, and 76-79." [Final Office Action, paragraph 4, page 5].

3.11.1.2 The Examiner's Evidence is Flawed and is Not Substantial Evidence

Appellants respectfully assert that nothing in the cited portions of Gregory and / or Foreman asserted by the Examiner (concerning claims **70, 73, and 76-79**) and reproduced in Sections 3.4.4.1. and 3.5.4.1. above teaches or suggests to produce a gift certificate that *does not include the account identifier* as recited by claim **85**. For purposes of brevity, Appellants incorporate the arguments made in Sections 3.4.1.2 and 3.5.4.2 in their entirety, and reassert that the Examiner has failed to establish substantial evidence that all of the features of the GROUP I claims and the GROUP II claims were known. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of the GROUP VIII claim **85**.

3.11.2 No Motivation to Combine the Cited References

As explained above in Sections 3.4.2 and 3.5.2, the Examiner has failed to show (i) that the prior art of record provides substantial evidence of a teaching, suggestion, or motivation to make the proposed combination or modification of the asserted teachings of the prior art, and (ii) that this properly supported combination or modification would provide for the

specific features of the claimed invention. Appellants herein incorporate the arguments made in Sections 3.4.2. and 3.5.2. by reference in their entirety herein, and accordingly reassert that one skilled in the art would not have been motivated to combine the Gregory and Foreman references.

Accordingly, the Examiner has not presented a *prima facie* case of obviousness of claim **85** of GROUP VIII.

3.11.2.1. No Showing of Level of Ordinary Skill in the Art

As presented above in Section 3.4.2.3., Appellants submit that the Examiner has also failed to resolve (or even identify) the level of ordinary skill in the pertinent art as required by the Supreme Court. Graham v. John Deere Co., 383 U.S. 1, 17 (1966). Having failed to resolve the level of ordinary skill in the art in the record, Appellants asseverate that the Examiner is unable to determine what “would have been obvious to one of ordinary skill in the art” at the time of the invention.

In summary, the Examiner has not established a *prima facie* case of obviousness with respect to claim **85** of GROUP VIII because the Examiner has not shown (i) that all of the limitations of claim **85** are taught by the references of record, alone or in combination; nor (ii) a motivation in the prior art of record to combine the references in any manner that renders claim **85** obvious. The rejection fails for at least this reason.

3.12. Group IX: Claim 86

GROUP IX includes dependent claim **86**. Claim **86** depends on independent claim **83**, and provides *in which the alias identifier comprises at least fifteen digits*.

The 35 U.S.C. §103(a) rejection of the GROUP IX claim **86** is flawed at least because the Examiner has not made a *prima facie* case of unpatentability of claim **83** (GROUP VII). Specifically, the Examiner has not shown that each of the claim limitations of independent claim **83** is taught or suggested by the prior art. Further, as explained above, the Examiner has not provided a proper motivation to combine the references in the manner suggested.

Further, claim **86** cannot be deemed obvious in light of the references of record, alone or in any combination, because the cited references, alone or in any combination, cannot be interpreted in a manner that would disclose or suggest the limitations of any pending claim.

3.12.1 The Cited Art Does Not Disclose the Limitation of Claim 86

3.12.1.1. Examiner's Asserted Factual Findings

The Examiner states: “With respect to claim 86, this dependent claim is rejected for the similar rationale as given above for claim 81.” [Final Office Action, paragraph 4, page 5].

3.12.1.2 The Examiner's Evidence is Flawed and is Not Substantial Evidence

Appellants respectfully assert that nothing in the cited portions of Gregory and / or Foreman asserted by the Examiner (concerning claim 81) and reproduced in Section 3.8.1.1. above, teaches or suggests to produce a gift certificate *in which the alias identifier comprises at least fifteen digits* as recited by claim 86. For purposes of brevity, Appellants incorporate the arguments made in Section 3.8.1.2 in their entirety, and reassert that the Examiner has failed to establish substantial evidence that all of the features of the GROUP V claim were known. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of the GROUP IX claim 86.

3.12.2 No Motivation to Combine the Cited References

As explained above in Section 3.8.2, the Examiner has failed to show (i) that the prior art of record provides substantial evidence of a teaching, suggestion, or motivation to make the proposed combination or modification of the asserted teachings of the prior art, and (ii) that this properly supported combination or modification would provide for the specific features of the claimed invention. Appellants herein incorporate the arguments made in Section 3.8.2. in their entirety herein, for purposes of brevity, and reassert that one skilled in the art would not have been motivated to combine the Gregory and Foreman references.

Accordingly, the Examiner has not presented a *prima facie* case of obviousness of claim 86.

3.12.2.1. No Showing of Level of Ordinary Skill in the Art

As presented above in Section 3.4.2.3., Appellants submit that the Examiner has also failed to resolve (or even identify) the level of ordinary skill in the pertinent art as required by the Supreme Court. Graham v. John Deere Co., 383 U.S. 1, 17 (1966). Having failed to resolve the level of ordinary skill in the art in the record, Appellants asseverate that the Examiner is unable to determine what “would have been obvious to one of ordinary skill in the art” at the time of the invention.

In summary, the Examiner has not established a *prima facie* case of obviousness with respect to claim **86** of GROUP IX because the Examiner has not shown (i) that all of the limitations of claim **86** (and independent claims **81** and **83**) are taught by the references of record, alone or in combination; nor (ii) a motivation in the prior art of record to combine the references in any manner that renders claim **86** obvious. The rejection fails for at least this reason.

3.13. Group X: Claim 87

GROUP X includes dependent claim **87**. Claim **87** depends on independent claim **83**, and provides *in which the recipient is the owner of the financial account*.

The 35 U.S.C. §103(a) rejection of the GROUP X claim **87** is flawed at least because the Examiner has not made a *prima facie* case of unpatentability of claim **83** (GROUP VII). Specifically, the Examiner has not shown that each of the claim limitations of independent claim **83** is taught or suggested by the prior art. Further, as explained above, the

Examiner has not provided a proper motivation to combine the references in the manner suggested.

Further, claim 87 cannot be deemed obvious in light of the references of record, alone or in any combination, because the cited references, alone or in any combination, cannot be interpreted in a manner that would disclose or suggest the limitations of any pending claim.

3.13.1 The Cited Art Does Not Disclose the Limitation of Claim 87

3.13.1.1. Examiner's Asserted Factual Findings

The Examiner states: "With respect to claim 87, Gregory teaches, The (sic) method of claim 83, in which the recipient is an owner of the financial account (col. 17, lines 10-65)." [Final Office Action, paragraph 4, page 5].

The text of Gregory at Column 17, lines 10-65 recites:

Referring again to block 118, if a determination is made that the user wishes to select "beer drafts", the process passes to block 260 as illustrated through block 132 FIG. 3I. Block 260 depicts the establishment of a beer draft log. Each time a beer draft is printed a description of the beer draft is entered into the current beer draft log file. The description includes the date and time the draft is printed, the store where the beer draft is printed, the amount of the beer draft, the check number, the vendor invoice number and the vendor name.

Thereafter the process passes to block 262 which illustrates the establishment of a file which may contain valid vendor names and their associated vendor identification numbers. Next the process passes to block 264 which illustrates the prompting of the user to enter the user's password. Thereafter the process passes to block 266 which illustrates a determination of whether or not the entered password was valid. If a determination is made that the entered password was not valid, the process passes to block 66 as illustrated through block 162. Referring again to block 266, if a determination is made that the entered password is valid, the process passes to block 268 which illustrates the specification of a

vendor identification number.

The process then passes to block 270 which illustrates a determination of whether or not the specified vendor identification number is valid. If a determination is made that the vendor identification number is not valid, the process passes to block 66 as illustrated through block 162. Referring again to block 270, if a determination is made that the specified vendor identification number is valid, the process passes to block 272 which illustrates the specification of an invoice number. Thereafter the process passes to block 274 which illustrates the entering of an amount for the beer draft. Next the process passes to block 276 which illustrates a determination of whether or not the entered amount is less than or equal to \$2,500. A maximum amount for a beer draft may be arbitrarily set by the home office to limit its liability. If the entered amount is not less than or equal to \$2,500, the process again passes to block 274. Referring again to block 276, if a determination is made the entered amount is less than or equal to \$2,500, the process passes to block 290 as illustrated through block 278 FIG. 3J.

Block 290 illustrates the determination of a fee to be collected from the customer for the beer draft. Thereafter the process passes to block 292 which illustrates the displaying of the total amount to be collected which includes the amount of the beer draft plus the fee to be collected. Block 294 illustrates the association of an identifying number with the amount of this beer draft. Thereafter block 296 illustrates the displaying of the identifying number of this beer draft. Thereafter the process passes to block 298 which illustrates a determination of whether or not the user wishes to print another beer draft for the same vendor and same invoice number. If a determination is made that the user does wish to print another beer draft, the process passes back to block 274 as illustrated through block 300.

3.13.1.2 The Examiner's Evidence is Flawed and is Not Substantial Evidence

First, Appellants assert that the quoted section of Gregory reproduced above has nothing at all to do with a gift certificate as recited by independent claim 83 and *in which the recipient is the owner of the financial account* as recited by claim 87. Second, nothing in the cited portions of Gregory and /

or Foreman asserted by the Examiner and reproduced in Section 3.10.1.1. above, teaches or suggests to produce a gift certificate *in which the recipient is the owner of the financial account*. For purposes of brevity, Appellants incorporate the arguments made in Section 3.10.1.2 in their entirety, and reassert that the Examiner has failed to establish substantial evidence that all of the features of the GROUP X claim were known. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of the GROUP X claim **87**.

3.13.2 No Motivation to Combine the Cited References

As explained above in Section 3.10.2, the Examiner has failed to show (i) that the prior art of record provides substantial evidence of a teaching, suggestion, or motivation to make the proposed combination or modification of the asserted teachings of the prior art, and (ii) that this properly supported combination or modification would provide for the specific features of the claimed invention. Appellants herein incorporate the arguments made in Section 3.10.2. in their entirety herein, for purposes of brevity, and reassert that one skilled in the art would not have been motivated to combine the Gregory and Foreman references.

Accordingly, the Examiner has not presented a *prima facie* case of obviousness of claim **87**.

3.13.2.1. No Showing of Level of Ordinary Skill in the Art

As presented above in Section 3.4.2.3., Appellants submit that the Examiner has also failed to resolve (or even identify) the level of ordinary skill in the pertinent art as required by the Supreme Court. Graham v. John

Deere Co., 383 U.S. 1, 17 (1966). Having failed to resolve the level of ordinary skill in the art in the record, Appellants asseverate that the Examiner is unable to determine what “would have been obvious to one of ordinary skill in the art” at the time of the invention.

In summary, the Examiner has not established a *prima facie* case of obviousness with respect to claim 87 of GROUP X because the Examiner has not shown (i) that all of the limitations of claim 87 (and independent claim 83) are taught by the references of record, alone or in combination; nor (ii) a motivation in the prior art of record to combine the references in any manner that renders claim 87 obvious. The rejection fails for at least this reason.

3.14. Group XI: Claim 88

GROUP XI includes dependent claim 88. Claim 88 depends on independent claim 83, and provides *in which the financial account is a credit card account.*

The 35 U.S.C. §103(a) rejection of the GROUP XI claim 88 is flawed at least because the Examiner has not made a *prima facie* case of unpatentability of claim 83 (GROUP VII). Specifically, the Examiner has not shown that each of the claim limitations of independent claim 83 is taught or suggested by the prior art. Further, as explained above, the Examiner has not provided a proper motivation to combine the references in the manner suggested.

Further, claim **88** cannot be deemed obvious in light of the references of record, alone or in any combination, because the cited references, alone or in any combination, cannot be interpreted in a manner that would disclose or suggest the limitations of any pending claim.

3.14.1 The Cited Art Does Not Disclose the Limitation of Claim 88

3.14.1.1. Examiner's Asserted Factual Findings

The Examiner states: “With respect to claim 88, Gregory and Foreman fail to teach, The (sic) method of claim 83, in which the financial account is a credit card account, but it would have been obvious ton one having ordinary skill in the art... to have the financial account to be (sic.) a credit card account because the gift certificate purchaser will have to use some form of payment for the purchase of the gift certificate. A credit card account is a design choice as a method of payment.” [Final Office Action, paragraph 4, page 5].

3.14.1.2 The Examiner's Evidence is Flawed and is Not Substantial Evidence

Appellants respectfully assert that the Examiner has not provided any evidence in support of her assertions concerning claim **88**. The Examiner simply asserts that this would have been an obvious modification—“a design choice as a method of payment.” The Examiner’s conclusory and pejorative description of a “credit card account as a method of payment” and as a “design choice” is not evidence of obviousness. Invention requires design choice. The Examiner’s designation of the feature as “design choice” thus

appears to merely re-state that the feature is an obvious modification, without providing any evidentiary basis for that assertion.

Consequently, it appears that the Examiner is relying upon either the Examiner's own knowledge or some other evidence not made of record for these assertions as to:

- (i) what was known at the time of the invention, and
- (ii) the alleged desirability of modifying the combined Gregory and Foreman references to provide for the specific missing feature.

However, a *prima facie* case of obviousness requires substantial evidence of the Examiner's findings. As the Examiner has failed to establish the requisite substantial evidence of all of the features of claim 88, she has failed to establish a *prima facie* case of obviousness of claim 88.

In addition, for purposes of brevity, Appellants incorporate the arguments made in Section 3.10.1.2 concerning independent claim 83 in their entirety, and reassert that the Examiner has failed to establish substantial evidence that all of the features of the GROUP VII claim were known. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of the GROUP XI claim 88.

3.14.2 No Motivation to Combine the Cited References

As explained above in Section 3.10.2, the Examiner has failed to show (i) that the prior art of record provides substantial evidence of a teaching, suggestion, or motivation to make the proposed combination or modification of the asserted teachings of the prior art, and (ii) that this properly supported combination or modification would provide for the specific features of the claimed invention. Appellants herein incorporate the arguments made in

Section 3.10.2. in their entirety herein, for purposes of brevity, and reassert that one skilled in the art would not have been motivated to combine the Gregory and Foreman references.

Accordingly, the Examiner has not presented a *prima facie* case of obviousness of claim 88.

3.14.2.1. No Showing of Level of Ordinary Skill in the Art

As presented above in Section 3.4.2.3., Appellants submit that the Examiner has also failed to resolve (or even identify) the level of ordinary skill in the pertinent art as required by the Supreme Court. Graham v. John Deere Co., 383 U.S. 1, 17 (1966). Having failed to resolve the level of ordinary skill in the art in the record, Appellants asseverate that the Examiner is unable to determine what “would have been obvious to one of ordinary skill in the art” at the time of the invention.

In summary, the Examiner has not established a *prima facie* case of obviousness with respect to claim 88 of GROUP XI because the Examiner has not shown (i) that all of the limitations of claim 88 (and independent claim 83) are taught by the references of record, alone or in combination; nor (ii) a motivation in the prior art of record to combine the references in any manner that renders claim 88 obvious. The rejection fails for at least this reason.

3.15. Group XII: Claim 89

GROUP XII includes dependent claim **89**. Claim **89** depends on independent claim **83**, and provides *in which the financial account is a checking account*.

The 35 U.S.C. §103(a) rejection of the GROUP XII claim **89** is flawed at least because the Examiner has not made a *prima facie* case of unpatentability of claim **83** (GROUP VII). Specifically, the Examiner has not shown that each of the claim limitations of independent claim **83** is taught or suggested by the prior art. Further, as explained above, the Examiner has not provided a proper motivation to combine the references in the manner suggested.

Further, claim **89** cannot be deemed obvious in light of the references of record, alone or in any combination, because the cited references, alone or in any combination, cannot be interpreted in a manner that would disclose or suggest the limitations of any pending claim.

3.15.1 The Cited Art Does Not Disclose the Limitation of Claim 89

3.15.1.1. Examiner's Asserted Factual Findings

The Examiner states: "With respect to claim 89, Gregory teaches, The (sic.) method of claim 83, in which the financial account is a checking account (col. 1, lines 49-59)." [Final Office Action, paragraph 4, page 6].

The text of Gregory at Column 1, lines 49-59 recites:

Financial instruments may be created by completing a pre-printed form, such as that supplied by a financial institution to be used as personal checks. These pre-printed checks are

typically sold to a consumer by the financial institution. These checks typically are pre-printed with parameters including a number which identifies the associated financial institution, an account number, the printed name of the financial institution, a check number, and other personal information regarding the person or entity owning the account such as name, address, telephone number, or driver's license number.

3.15.1.2 The Examiner's Evidence is Flawed and is Not Substantial Evidence

Appellants respectfully assert that nothing in the cited portions of Gregory reproduced above, or in the cited portions of Gregory and / or Foreman asserted by the Examiner and reproduced in Section 3.10.1.1. above concerning claim 83, teaches or suggests to produce a *gift certificate including an alias identifier, and in which the financial account is a checking account* as recited by claim 89. For purposes of brevity, Appellants incorporate the arguments made in Section 3.10.1.2 in their entirety, and reassert that the Examiner has failed to establish substantial evidence that all of the features of the GROUP VII claim were known. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of the GROUP XII claim 89.

3.15.2 No Motivation to Combine the Cited References

As explained above in Section 3.10.2, the Examiner has failed to show (i) that the prior art of record provides substantial evidence of a teaching, suggestion, or motivation to make the proposed combination or modification of the asserted teachings of the prior art, and (ii) that this properly supported combination or modification would provide for the specific features of the

claimed invention. Appellants herein incorporate the arguments made in Section 3.10.2. in their entirety herein, for purposes of brevity, and reassert that one skilled in the art would not have been motivated to combine the Gregory and Foreman references.

Accordingly, the Examiner has not presented a *prima facie* case of obviousness of claim **89**.

3.15.2.1. No Showing of Level of Ordinary Skill in the Art

As presented above in Section 3.4.2.3., Appellants submit that the Examiner has also failed to resolve (or even identify) the level of ordinary skill in the pertinent art as required by the Supreme Court. Graham v. John Deere Co., 383 U.S. 1, 17 (1966). Having failed to resolve the level of ordinary skill in the art in the record, Appellants asseverate that the Examiner is unable to determine what “would have been obvious to one of ordinary skill in the art” at the time of the invention.

In summary, the Examiner has not established a *prima facie* case of obviousness with respect to claim **89** of GROUP XII because the Examiner has not shown (i) that all of the limitations of claim **89** (and independent claim **83**) are taught by the references of record, alone or in combination; nor (ii) a motivation in the prior art of record to combine the references in any manner that renders claim **89** obvious. The rejection fails for at least this reason.

3.16. Group XIII: Claim 90

GROUP XIII includes dependent claim 90. Claim 90 depends on independent claim 83, and provides:

in which the gift certificate comprises at least one of:

- a paper certificate,*
- a stored value card, and*
- a magnetic stripe card.*

The 35 U.S.C. §103(a) rejection of the GROUP XIII claim 90 is flawed at least because the Examiner has not made a *prima facie* case of unpatentability of claim 83 (GROUP VII). Specifically, the Examiner has not shown that each of the claim limitations of independent claim 83 is taught or suggested by the prior art. Further, as explained above, the Examiner has not provided a proper motivation to combine the references in the manner suggested.

Further, claim 90 cannot be deemed obvious in light of the references of record, alone or in any combination, because the cited references, alone or in any combination, cannot be interpreted in a manner that would disclose or suggest the limitations of any pending claim.

3.16.1 The Cited Art Does Not Disclose the Limitation of Claim 90

3.16.1.1 Examiner's Asserted Factual Findings

The Examiner states: "With respect to claim 90, Gregory teaches, The (sic.) method of claim 83, in which the gift certificate comprises at least one of: a paper certificate (col. 17, lines 52-65 and

fig. 6), a stored value card (col. 1, lines 49-59). Gregory and Foreman fail to teach, a magnetic stripe card but it would have been obvious to one having ordinary skill... to have a magnetic stripe card and to modify in Gregory because such a modification would allow Gregory to have a card that contains a dollar amount limit when swiped deducts a dollar amount from the card." [Final Office Action, paragraph 4, page 6].

The text of Gregory at Column 17, lines 52-65 recites:

Block 290 illustrates the determination of a fee to be collected from the customer for the beer draft. Thereafter the process passes to block 292 which illustrates the displaying of the total amount to be collected which includes the amount of the beer draft plus the fee to be collected. Block 294 illustrates the association of an identifying number with the amount of this beer draft. Thereafter block 296 illustrates the displaying of the identifying number of this beer draft. Thereafter the process passes to block 298 which illustrates a determination of whether or not the user wishes to print another beer draft for the same vendor and same invoice number. If a determination is made that the user does wish to print another beer draft, the process passes back to block 274 as illustrated through block 300.

And the text of Gregory at Column 1, lines 49-59 recites:

Financial instruments may be created by completing a pre-printed form, such as that supplied by a financial institution to be used as personal checks. These pre-printed checks are typically sold to a consumer by the financial institution. These checks typically are pre-printed with parameters including a number which identifies the associated financial institution, an account number, the printed name of the financial institution, a check number, and other personal information regarding the person or entity owning the account such as name, address, telephone number, or driver's license number.

3.16.1.2 The Examiner's Evidence is Flawed and is Not Substantial Evidence

Appellants respectfully assert that nothing in the cited portions of Gregory reproduced above, or in the cited portions of Gregory and / or Foreman asserted by the Examiner and reproduced in Section 3.10.1.1. above concerning claim 83, teaches or suggests to produce a gift certificate that may comprise *a stored value card* or *a magnetic stripe card* as recited by claim 90. For purposes of brevity, Appellants incorporate the arguments regarding claim 83 made in Section 3.10.1.2 in their entirety, and reassert that the Examiner has failed to establish substantial evidence that all of the features of the GROUP VII claim were known. Accordingly, at least for these reasons, the Examiner has failed to establish a *prima facie* case of obviousness of the GROUP XIII claim 90.

3.16.2 No Motivation to Combine the Cited References

As explained above in Section 3.10.2, the Examiner has failed to show (i) that the prior art of record provides substantial evidence of a teaching, suggestion, or motivation to make the proposed combination or modification of the asserted teachings of the prior art, and (ii) that this properly supported combination or modification would provide for the specific features of the claimed invention. Appellants herein incorporate the arguments made in Section 3.10.2. in their entirety herein, for purposes of brevity, and reassert that one skilled in the art would not have been motivated to combine the Gregory and Foreman references.

Accordingly, the Examiner has not presented a *prima facie* case of obviousness of claim 90.

3.16.2.1. No Showing of Level of Ordinary Skill in the Art

As presented above in Section 3.4.2.3., Appellants submit that the Examiner has also failed to resolve (or even identify) the level of ordinary skill in the pertinent art as required by the Supreme Court. Graham v. John Deere Co., 383 U.S. 1, 17 (1966). Having failed to resolve the level of ordinary skill in the art in the record, Appellants asseverate that the Examiner is unable to determine what “would have been obvious to one of ordinary skill in the art” at the time of the invention.

In summary, the Examiner has not established a *prima facie* case of obviousness with respect to claim 90 of GROUP XIII because the Examiner has not shown (i) that all of the limitations of claim 90 (and independent claim 83) are taught by the references of record, alone or in combination; nor (ii) a motivation in the prior art of record to combine the references in any manner that renders claim 90 obvious. The rejection fails for at least this reason.

3.17. Group XIV: Claim 91

Independent method claim 91 recites:

determining stored account data associated with a financial account, in which the account data includes an account identifier that identifies a credit card account; generating, by a computer, an alias account number that provides an indirect link to the credit card account, in which the alias account number is different from the account

identifier, and in which the alias account number comprises at least fifteen numeric digits;

producing a magnetic stripe card, the magnetic stripe card including the alias account number; and

providing the magnetic stripe card to a recipient.

3.17.1. The References Do Not Disclose All the Limitations of Independent Claim 91

Specifically, no combination of the references could suggest all of the following features generally recited in claim 91:

- A. generating, by a computer, an alias account number
 - in which
 - (i) the alias account number provides an indirect link to a credit card account
 - (ii) the credit card account is identified by an account identifier
 - (iii) the alias account number is different from the account identifier, and

- B. producing a magnetic stripe card
 - in which the magnetic stripe card includes the alias account number that is described in (i)-(iii).

3.17.1.1 Examiner's Asserted Factual Findings

As Appellants best understand the rejection of independent claim 91, the Examiner asserts the following to be true:

Gregory discloses all of the features of Claim 91 except “generating an alias identifier that provides an indirect link to the financial account, in which the alias identifier is different from the account identifier; producing a gift certificate, the gift certificate including the alias identifier; and providing the gift certificate to a recipient”; and

Foreman discloses “generating an alias identifier that provides an indirect link to the financial account, in which the alias identifier is different from the account identifier; producing a gift certificate, the gift certificate including the alias identifier; and providing the gift certificate to a recipient.”

[Final Office Action, pages 4-5].

First, Appellants note that the Examiner rejected independent claims 83 (GROUP VII) and 91 (GROUP XIV) together, and thus chose to ignore various features of claim 91 that are not shared with independent claim 83. In particular, claim 83 recites a method that includes an *alias identifier* that *provides an indirect link to a financial account*, wherein *the alias identifier is different from an account identifier*, and then producing *a gift certificate* that includes the *alias identifier*. Claim 91 is directed to a method for *producing a magnetic stripe card*, which includes generating *an alias account number* that *provides an indirect link to a credit card account, in which the alias account number is different from the account identifier*, and

that requires that the alias account number comprise *at least fifteen numeric digits*, and that also specifies that the magnetic stripe card includes *the alias account number*. Appellants respectfully assert that at least these ignored features are not taught or suggested by the cited art.

Secondly, Appellants dispute that Foreman discloses or suggests what the Examiner asserts, and do not necessarily agree that Gregory teaches all of the other features of claim 91. Arguments against the Examiner's assertions with respect to Gregory, however, are not presented herein for the sake of brevity, as such arguments are moot given the Examiner's failure to establish a *prima facie* case of obviousness (as explained below) even if those assertions are true.

The Examiner asserts that Foreman teaches all of the features missing from Gregory at Column 6, lines 26-47. [Final Office Action, page 5].

The text of Foreman at Column 6, lines 26-47 is provided below, with emphasis added:

Referring now to FIGS. 8 and 9, the blank money order forms 24 have a serial number 34 printed along a leading edge 36 of the form 24. A timing mark 38 is placed on the back of each money order form 24 falling in a **predetermined numbered sequence** in the fan folded bundle 50 of money order forms 24. **The corresponding serial number 34 of the particular money order form** bearing the timing mark must be evenly devisable by the number of the position location of the form in the bundle. In other words, if the timing mark 38 appears on every fourth money order form, the serial number 34 of the fourth money order form should be devisable by four. When the mark 38 is sensed by a sensing mechanism contained within the printer 20, the serial number 34 is read and a determination made whether it is devisable by the appropriate number. If not, printing of the money order will not occur and the sequence and alignment of the money order forms 24 must be checked by the operator of the dispenser 10. Thus, the timing marks 38 prevent the unauthorized removal of a blank money order form, which would result in an out of sequence serial number 34.

The Examiner also asserts: “a predetermined number sequence corresponding to the serial number of a particular money order form (gift certificate) which is considered an alias identifier.” [Final Office Action, page 5].

3.17.1.2 The Examiner’s Evidence is not Substantial Evidence

Appellants submit that the cited portion of Foreman of Column 6 reproduced above is directed to a description of how that system ensures that blank money order forms are printed in the proper sequence, and of how an unauthorized removal of a blank form could be detected. Furthermore, Appellants assert that the Examiner’s interpretation of this passage is strained beyond reason. Appellants hereby incorporate all of the arguments found in Section 3.10.1.2 for the sake of brevity. Accordingly, it is again submitted that the Examiner’s finding, that a serial number in Foreman is an alias of itself, is an erroneous and unreasonable interpretation of what is disclosed by Foreman.

The Examiner has thus failed to establish substantial evidence that all of the features of claim 91 were known. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of GROUP XIV independent claim 91.

3.17.2. No Motivation to Combine the Cited References

The Examiner must also show:

(i) that the prior art of record provides substantial evidence of a teaching, suggestion, or motivation to make the proposed combination or modification of the asserted teachings of the prior art, and

(ii) that this properly supported combination or modification would provide for the specific features of the claimed invention

3.17.2.1 Examiner's Asserted Factual Findings

The Examiner asserts: “It would have been obvious...to generate an alias identifier that provides an indirect link to the financial account, in which the alias identifier is different from the account identifier; and providing the gift certificate to a recipient and to modify in Gregory because such a modification would allow Gregory to have a predetermined number sequence corresponding to the serial number of a particular money order form (gift certificate” which is considered an alias identifier.” [Final Office Action, page 5].

3.17.2.2. The Examiner's Evidence is not Substantial

The Examiner did not cite any particular portion of Foreman in support of the asserted motivation to provide specifically for generating, by a computer, an alias account number that provides an indirect link to the credit card account, in which the alias account number is different from the account identifier; and for producing a magnetic stripe card, the magnetic stripe card including the alias account number. As explained above and in Section 3.10.1.2 (which is incorporated in its entirety), the cited passages in Column 6 of Foreman do not support the Examiner's interpretation that an alias account number is being generated. In particular, Appellants reassert the position that the Examiner's apparently strained finding, that a serial number in Foreman is an alias of itself, is clearly erroneous and / or unreasonable.

For the sake of brevity, Appellants incorporate the arguments of Section 3.10.2.2. herein, and thus reassert that the Examiner has employed impermissible hindsight based on the present disclosure to justify applying Foreman's process for detecting unauthorized removal of blank money order forms against the claimed subject matter.

Accordingly, the asserted motivation cannot suggest the desirability of the particular feature the Examiner concedes is missing in Gregory. The Appellants thus submit that the Examiner has failed to establish substantial evidence of a proper motivation to combine or modify the Gregory system to provide for *a magnetic stripe card including at least a fifteen-digit alias account number...in which the fifteen-digit alias account number is an alias of an account identifier that provides an indirect link to a credit card account*. Consequently, the Examiner has failed to establish a *prima facie* case of obviousness of GROUP XIV claim 91.

3.17.2.3. No Showing of Level of Ordinary Skill in the Art

As presented above in Section 3.4.2.3., Appellants also submit that the Examiner has failed to resolve (or even identify) the level of ordinary skill in the pertinent art as required by the Supreme Court. Graham v. John Deere Co., 383 U.S. 1, 17 (1966). Having failed to resolve the level of ordinary skill in the art in the record, Appellants asseverate that the Examiner is unable to determine what “would have been obvious to one of ordinary skill in the art” at the time of the invention.

In summary, the Examiner has not established a *prima facie* case of obviousness with respect to claim 91 of GROUP XIV because the Examiner has not shown (i) that all of the limitations of claim 91 are taught by the

references of record, alone or in combination; nor (ii) a motivation in the prior art of record to combine the references in any manner that renders claim 91 obvious. The rejection fails for at least this reason.

CONCLUSION

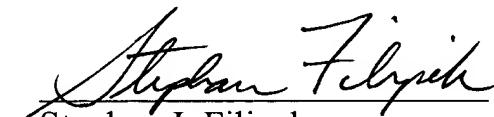
The Examiner's rejections of the pending claims are improper at least because the Examiner has not provided a proper legal basis for rejecting any claim. Therefore, Appellants respectfully request that the Examiner's rejections be reversed.

If any issues remain, or if there are any further suggestions for expediting allowance of the present application, please contact Stephan J. Filipek using the information provided below.

Appellants hereby request any extension of time that may be required to make this Appeal Brief timely. Please charge any fees that may be required for this paper, or credit any overpayment, to Deposit Account No. 50-0271.

May 8, 2006

Date



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APPENDIX A**CLAIMS INVOLVED IN THE APPEAL**

70. A method for issuing a gift certificate corresponding to a financial account, comprising the steps of:

generating, by a computer, a certificate identifier corresponding to an account identifier that is associated with a financial account, said certificate identifier being different from said account identifier;

producing a gift certificate including thereon said certificate identifier,

said gift certificate not including said account identifier; and

distributing said gift certificate to an owner of said financial account.

71. The method of claim 70 wherein the financial account identifier cannot be discerned from the gift certificate identifier by a third party.

72. The method of claim 70, further including the steps of:

receiving an indication of a gift certificate redemption; and
updating stored account data to reflect the redemption.

73. A method for issuing a gift certificate corresponding to a financial account, comprising the steps of:

generating, by a computer, a certificate identifier corresponding to an account identifier that is associated with a financial account, said certificate identifier being different from said account identifier;

producing a gift certificate including thereon said certificate identifier,

said gift certificate not including said account identifier; and distributing said gift certificate to a recipient.

74. The method of claim 73 wherein the financial account identifier cannot be discerned from the gift certificate identifier by a third party.

75. The method of claim 73, further including the steps of: receiving an indication of a gift certificate redemption; and updating stored account data to reflect the redemption.

76. A system for issuing a gift certificate drawn on a financial account, comprising:

computer means for generating a certificate identifier corresponding to an account identifier that is associated with a financial account, said certificate identifier being different from said account identifier;

means for producing a gift certificate including thereon said certificate identifier,

said gift certificate not including said account identifier; and means for distributing said gift certificate to an owner of said financial account.

77. A system for issuing a gift certificate drawn on a financial account, comprising:

computer means for generating a certificate identifier corresponding to an account identifier that is associated with a financial account, said certificate identifier being different from said account identifier;

means for producing a gift certificate including thereon said certificate identifier,

said gift certificate not including said account identifier; and means for distributing said gift certificate to a recipient.

78. A computer-readable storage medium encoded with processing instructions for implementing a method for issuing a gift certificate drawn on a financial account, said processing instructions for directing a computer to perform the steps of:

generating a certificate identifier corresponding to an account identifier that is associated with a financial account, said certificate identifier being different from said account identifier;

producing a gift certificate including thereon said certificate identifier,

said gift certificate not including said account identifier; and distributing said gift certificate to an owner of said financial account.

79. A computer-readable storage medium encoded with processing instructions for implementing a method for issuing a gift certificate drawn on a financial account, said processing instructions for directing a computer to perform the steps of:

generating a certificate identifier corresponding to an account identifier that is associated with a financial account, said certificate identifier being different from said account identifier;

producing a gift certificate including thereon said certificate identifier,

said gift certificate not including said account identifier; and
distributing said gift certificate to a recipient.

81. A method comprising:

producing a gift certificate,

the gift certificate including a sixteen-digit certificate identifier,

in which the sixteen-digit certificate is determined by a computer,

in which the sixteen-digit certificate identifier is an alias of an account identifier that identifies a financial account, and

in which the account identifier identifies a credit card account; and

distributing the gift certificate to an owner of the credit card account.

82. The method of claim 81, in which the gift certificate is for a single use.

83. A method comprising:

 determining stored account data associated with a financial account,

 in which the account data includes an account identifier that identifies the financial account;

 generating, by a computer, an alias identifier that provides an indirect link to the financial account,

 in which the alias identifier is different from the account identifier;

 producing a gift certificate, the gift certificate including the alias identifier; and

 providing the gift certificate to a recipient.

84. The method of claim 83, in which the gift certificate is for a single use.

85. The method of claim 83, in which the gift certificate does not include the account identifier.

86. The method of claim 83, in which the alias identifier comprises at least fifteen digits.

87. The method of claim 83, in which the recipient is an owner of the financial account.

88. The method of claim 83, in which the financial account is a credit card account.

89. The method of claim 83, in which the financial account is a checking account.

90. The method of claim 83, in which the gift certificate comprises at least one of:

- a paper certificate,
- a stored value card, and
- a magnetic stripe card.

91. A method comprising:
determining stored account data associated with a financial account,
in which the account data includes an account identifier that identifies a credit card account;
generating, by a computer, an alias account number that provides an indirect link to the credit card account,
in which the alias account number is different from the account identifier, and
in which the alias account number comprises at least fifteen numeric digits;
producing a magnetic stripe card,

the magnetic stripe card including the alias account number;
and
providing the magnetic stripe card to a recipient.

APPENDIX B – EVIDENCE

<NONE>

APPENDIX C – RELATED PROCEEDINGS

<NONE>